

61  
March 7, 2005



AF 2614

In re Patent Application of:

John C. Harvey and  
James W. Cuddihy

Attorney Docket No.: 5634.0355

Application No.: 08/487,526

Group Art Unit: 2614

Filed: June 7, 1995

Examiner: HARVEY, David E.

Title: SIGNAL PROCESSING APPARATUS AND METHODS

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA

Transmitted herewith is a Petition for Extension of Time Under 37 C.F.R. § 1.136, and Brief in Support of an Appeal.

CLAIMS AS AMENDED						
	Claims Remaining After Amendment	Highest Number Previously Paid For	Extra	Rate		Amount
				Large Entity	Small Entity	
Number of Claims in Excess of 20	76	76	0	\$ 50.00	\$ 25.00	\$ 0.00
Independent Claims in Excess of 3	12	12	0	\$ 200.00	\$ 100.00	\$ 0.00
First Presentation of Multiple Dependent Claims				\$ 360.00	\$ 180.00	\$ 0.00
Extension Fee:	a) One Month			\$ 120.00	\$ 60.00	\$ 0.00
	b) Two Months			\$ 450.00	\$ 225.00	\$ 0.00
	c) Three Months			\$ 1020.00	\$ 510.00	\$ 1020.00
	d) Four Months			\$ 1590.00	\$ 795.00	\$ 0.00
	e) Five Months			\$ 2160.00	\$ 1080.00	\$ 0.00
Other:	Brief in Support of an Appeal			\$ 500	\$ 250.00	\$ 500.00
TOTAL FEE DUE						\$ 1520.00

- ☐ No additional fee is required.  
☒ A check in the amount of \$ 1520 is attached.  
☐ Charge \$ \_\_\_\_\_ to Deposit Account No. 06-1075.  
☒ Charge any additional fees or credit any overpayment to Deposit Account No. 06-1075.

- Small Entity Status Claim:  
☐ is hereby requested.  
☐ is of record in this application.

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Respectfully submitted

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Alexandria, VA 22313-1450

**PETITION FOR THREE MONTH EXTENSION OF TIME**

Sir:

Applicants respectfully request a three month extension of time under 37 C.F.R. § 1.136(a) for submitting an Appeal Brief in support of the appeal noticed October 7, 2004, in the above-identified patent application, thereby extending the period for submitting the Appeal Brief to March 7, 2005.

Submitted herewith is a check, which includes \$1020 to cover the fee for the extension under 37 C.F.R. § 1.17(a)(2). Any deficiency in or overpayment of this fee should be charged or credited to Deposit Account No. 06-1075.

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**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicants : John C. HARVEY and  
James W. Cuddihy

Serial No. : 08/487,526

Filed : June 7, 1995

For : SIGNAL PROCESSING APPARATUS AND METHODS

Group Art Unit : 2614

Examiner : HARVEY, David E.

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Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313

**APPEAL BRIEF**

In accordance with 37 C.F.R. § 41.37, appellants submit this appeal brief in the above captioned application. Appellants appeal the final rejection of claims 2-18, 20-30, 33-42, and 67-104 set forth in the Office action mailed April 28, 2004 (the "Final Office Action"). A Notice of Appeal was filed in accordance with 37 C.F.R. § 41.31 on October 7, 2004. Attached hereto is a check for \$1520.00 covering the fee set forth in 37 C.F.R. 41.20(b)(2) and the three month extension fee under 37 C.F.R. § 1.136. Any additional fees that may be due but are not attached may be charged to Deposit Account No. 06-1075.

This application must be treated as special by the Office. This application has been pending for over nine years (having been filed on June 7, 1995) and, by claim of priority to Application No. 06/317,519 filed November 3, 1981, has an effective pendency of more than 23 years. The Office treats as special "[a]pplications pending more than 5 years, including those which, by relation to a prior United States application, have an effective pendency of more than 5 years." M.P.E.P. §§ 707.02 and 708.01(I) (8<sup>th</sup> Ed. Rev. 2, 2004). Accordingly, this application should be advanced out of turn and acted upon expediently.

### **Real Party In Interest**

The real party in interest is Personalized Media Communications, LLC (“PMC”) having a place of business at 708 Third Ave., New York, New York, 10017.

### **Related Appeals And Interferences**

The application is a continuation of Ser. No. 08/113,329, filed August 30, 1993, which remains pending and is a continuation of Ser. No. 56,501, filed May 3, 1993, now Pat. No. 5,335,277, which is a continuation of Ser. No. 849,226, filed March 10, 1992, now Pat. No. 5,233,654, which is a continuation of Ser. No. 588,126, filed September 25, 1990, now Pat. No. 5,109,414, which is a continuation of Ser. No. 96,096, filed September 11, 1987, now Pat. No. 4,965,825, which is a continuation-in-part of Ser. No. 829,531, filed February 14, 1986, now Pat. No. 4,704,725, which is a continuation of Ser. No. 317,510, filed November 3, 1981, now Pat. No. 4,694,490. Additionally, U.S. Patent 5,887,243 has issued from an application with an identical disclosure to the instant application and a claim of priority to the above chain of applications. These applications and patents have been involved in the following appeals and judicial proceedings.

Pat. Nos. 4,965,825; 5,109,414 and 5,335,277 were asserted in the U.S. District Court, Eastern District of Virginia in the case styled *Personalized Mass Media Corp. v. The Weather Channel, Inc. et al.*, Doc. No. 2:95cv242. The case was settled prior to any substantive decision by the Court, although one procedural decision was published at 899 F.Supp. 239 (E.D.Va. 1995).

Pat. No. 5,335,277 was involved in the matter of *Certain Digital Satellite System (DDS) Receivers and Components Thereof* before the United States International Trade Commission (“Commission”), Investigation No. 337-TA-392. The Administrative Law Judge (“ALJ”) issued an “Initial Determination Granting Motion for Summary Determination of Invalidity of Claim 35 of the ‘277 Patent” on May 16, 1997. This determination was appealed to the U.S. Court of Appeals for the Federal Circuit (“Federal Circuit”), which affirmed the Commission decision in a decision decided January 7, 1999. The ALJ issued “Initial and Recommended Determinations”

on October 31, 1997. The Commission adopted certain of the ALJ's findings and took no position on certain other issues in a "Notice Of Final Commission Determination Of No Violation Of Section 337 Of The Tariff Act Of 1930," dated December 4, 1997. This determination was appealed to the Federal Circuit, which affirmed-in-part, reversed-in-part, vacated-in-part, and remanded in a decision decided November 24, 1998 published at 161 F.3d 696, 48 U.S.P.Q.2d 1880. On remand, the complainant moved to terminate the investigation. The Commission issued a "Notice Of Commission Decision To Terminate The Investigation And To Vacate Portions Of The Initial Determination" on May 13, 1999.

Pat. Nos. 4,965,825; 5,109,414 and 5,335,277 were asserted in the U.S. District Court, Northern District of California in the case styled *Personalized Media Communications, LLC v. Thomson Consumer Electronics et al.*, Doc. No. C-96 20957 SW (EAI). The case was stayed during the Commission proceedings and was thereafter voluntarily dismissed by the plaintiffs. The Court issued no substantive decisions.

Each of the issued patents with the exception of Pat. No. 4,704,725 is also asserted in the U.S. District Court, District of Delaware in the case styled *Pegasus Development Corp. v. DIRECTV Inc.*, Doc. No. CA 00-1020 ("Delaware Action"). Special Master Robert L. Harmon has issued a "Report And Recommendation Of Special Master Regarding Claim Construction." The Court has taken no further action in this case as it has been stayed pending the reexamination proceedings discussed below.

Each of the issued patents is asserted in a suit pending in the U.S. District Court, Northern District of Georgia in the case styled *Personalized Media Communications, LLC v. Scientific-Atlanta, Inc. et al.*, Doc. No. 1:02-CV-824 (CAP) ("Atlanta Action"). This suit is proceeding, as it has not been stayed pending the reexamination proceedings.

The Defendants in the Delaware Action and the Atlanta Action have submitted requests for reexamination for each of the issued patents. Each of the reexamination requests have been granted. The pending reexamination proceedings are as follows:

Pat. No. 4,694,490     Control No. 90/006,800,  
Pat. No. 4,704,725     Control Nos. 90/006,697 and 90/006,841,  
Pat. No. 4,965,825     Control No. 90/006,536,  
Pat. No. 5,109,414     Control No. 90/006,838,  
Pat. No. 5,233,654     Control Nos. 90/006,606, 90/006,703 and 90/006,839,  
Pat. No. 5,335,277     Control Nos. 90/006,563 and 90/006,698, and  
Pat. No. 5,887,243     Control No. 90/006,688.

The Office has not yet issued a substantive action in any of these proceedings.

In pending Application No. 08/113,329 to which this application claims priority, an appeal was noticed on August 20, 1996, and briefed September 13, 1996. Prosecution was reopened without consideration and the disputed rejection withdrawn in an Office action mailed October 10, 1997.

An appeal was noticed on September 20, 2004, and an appeal brief filed on February 6, 2005 in copending Application No. 08/470,571.

#### **Status Of Claims**

Claims 2-18, 20-30, 33-42 and 67-104 are pending and stand rejected. The rejections of each of these claims are appealed. Claims 1, 19, 31, 32 and 43-66 have been cancelled.

#### **Status Of Amendments**

No amendments to the claims have been entered or proposed subsequent to final rejection.

#### **Summary Of The Invention**

The claims are generally directed to methods and apparatus for outputting multimedia presentations. The multiple media are received and identified for proper coordination. Independent claims 2, 20, 24, 26, 29 and 33 are directed to methods of outputting a multimedia presentation. Independent claims 37, 70, 74, 76, 85 and 95 are directed to multimedia presentation apparatus that generally correspond to the method claims. The rejections of each of

these independent claims are appealed. A concise explanation of the subject matter of each of these claims with exemplary citations to the specification is set forth below. The citations to the specification are to exemplary embodiments of the disclosed invention and should not be construed to limit the scope of the claims.

**1. Claims 2 And 37**

In the method of claim 2, a multimedia presentation is output through the coordination of a presentation, under computer control, using information from a first medium with a presentation of a second medium, whereby the presentation using information in the first medium has a predetermined relationship to the content of the second medium. Claim 37 sets forth a multimedia presentation apparatus that is generally analogous to the method of claim 2. The specification discloses a multimedia presentation in the form of a television program (the exemplary Wall Street Week program) coordinated with information related to the user's particular stock portfolio. (*See generally* Spec. pp. 19-28.) The multimedia presentation is output as an overlay of the user's own stock performance with a studio generated graphic within the Wall Street Week transmission. (Spec. p. 26, ll. 4-11.) The coordination is under the control of microcomputer 205. (Spec. p. 24, l. 22 to p. 25, l. 8.) What is coordinated is a presentation using information from a first medium containing stock quote information (Spec. p. 449, ll. 13-20 and ll. 26-35) with a presentation of a studio generated graphic of stock index performance within the Wall Street Week television program (Spec. p. 25, ll. 28-33). The presentation of the overlay of the user's stock performance has a predetermined relationship based on time and content with the studio-generated graphic of stock index performance. (Spec. p. 26, ll. 13-19.)

**2. Claims 20 And 70**

In the method of claim 20, a multimedia presentation is output through the coordination of a presentation of a first medium and information based on a second medium through the identification of the content of the first and second media. Claim 70 is an apparatus claim that is generally analogous to claim 20. As discussed above with respect to claim 2, the specification

discloses a first medium exemplified by the Wall Street Week television program and stock portfolio performance information based on stock quote information from a second medium. The Wall Street Week television program is identified based on an identifier included with the program transmission. (Spec. p. 435, l. 23 to p. 436, l. 1.) The stock quote information is also identified. (Spec. p. 449, ll. 13-35.)

### **3. Claims 26 And 76**

In the method of claim 26, a multimedia presentation of information included in one medium and information based on another medium is output, where content of each of the two media is identified and where one of the media is received from a remote transmitter station and the other medium is received from a different source. Claim 76 is an apparatus claim that is generally analogous to claim 26. As discussed above for claim 2, the specification discloses a multimedia presentation of the Wall Street Week television program in which information included in the television transmission and stock performance information based on stock prices from a remote data service is output. The content of both media is identified as discussed above with respect to claims 2 and 20. The television program is received from a remote broadcast station. (Spec. p. 20, ll. 21-29.) The stock price data is received by telephone from a remote data service. (Spec. p. 449, ll. 26-35.)

### **4. Claims 29 and 85**

In the method of claim 29, a multimedia presentation of a first medium and a video image is output through processing of a control signal at a receiver station which causes execution of processor instructions to create a series of discrete video images, whereby a video image of the series of discrete images is caused to be output after the identification of the first medium. Claim 85 is an apparatus claim that is generally analogous to claim 29. As discussed above for claim 2, the specification discloses a multimedia presentation of the Wall Street Week television program. A plurality of graphic overlays is created after the Wall Street Week program is identified. (Spec. p. 451, ll. 6-11.)



## **5. Claims 33 And 95**

In the method of claim 33, a multimedia presentation of information included in a first signal received from a remote transmitter station and information included in a second signal is output, whereby a user response is compared to information corresponding to content of the first signal in order to tune the receiver station to receive the second signal. Claim 95 is an apparatus claim generally analogous to claim 33. Claim 33 is generally supported by the section of the specification titled “Coordinating Computers, Television, and Print” at pages 469 *et seq.* In this section, a television presentation of a cooking show is used as an example. The television presentation of the show is included in a first signal. (Spec. p. 470, ll. 9-17.) Information regarding a recipe of the show is received in a second signal. (Spec. p. 473, ll. 3-13; p. 474, ll. 8-35; and p. 477, ll. 8-13.) A user response is compared to content recited in the television show. (Spec. p. 472, ll. 13-17.) The receiver station is tuned to receive the second signal. (Spec. p. 477, ll. 8-13.)

## **6. Claims 24 And 33**

In the method of claim 24, a multimedia presentation of a television program and a second medium is output, whereby information stored at a receiver station is compared to content of a television program to determine whether to present the second medium based on information received from a source different from that of the television program. Claim 74 is an apparatus claim that is generally analogous to claim 24. Claim 24 is similar in many respects to claim 33. During the cooking show, the user response is stored at the receiver station and compared to the content of the television program to determine whether to present the recipe. (Spec. p. 472, ll. 13-17; p. 477, ll. 8-13.) The recipe is received on a different channel than the television presentation. (See Spec. p. 317, ll. 2-6.)

**Grounds Of Rejection To Be Reviewed On Appeal**

Appellants find error in each of the outstanding rejections and requests that each ground of rejection in the Final Office Action be reviewed. The rejections presented in the Final Office Action are as follows:

Claims 2-18, 20-30, 33-42, and 67-104 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

Claims 70-73 (and all claims dependent therefrom) stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellants regard as the invention.

Claims 2-6 and 11-16 stand rejected under 35 U.S.C. § 102(b) as being anticipated by British patent 1 486 424.

Claim 2 stands rejected under 35 U.S.C. § 102(b) as being anticipated by British patent 1 405 141.

Claims 2-18, 20-23, 26, 27, 37-42, 67-69, 82-84 stand rejected under 35 U.S.C. § 102(b) as being anticipated by German patent application 29 04 981.

Claim 33 stands rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,008,000.

Claims 24, 25, 103, and 104 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 3,982,064 in view of Japanese patent publication 56-8975.

Claims 74 and 75 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 3,982,064 in view of Japanese patent publication 56-8975 and further in view of British patent specification 1 556 366.

Claims 26, 27, and 82 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Japanese published application 52-22423 and U.S. Patent No. 4,081,990.

Claims 26-28 stand under 35 U.S.C. § 103(a) as being unpatentable over Japanese published application 52-22423 in view of U.S. Patent No. 4,081,990 and U.S. Patent No. 4,218,710.

Claims 2-6, 11-16, 20-23, 29, 30, 76-81, and 85-94 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over any one of: British patent specification 871,238; British patent specification 959,274; and German unexamined application 23 59 969, in view of the publication "Controlling Cable TV Head Ends and Generating Messages by Means of a Micro Computer" by Robert E. Schloss et al.

Claims 17 and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over any one of: British patent specification 871,238; British patent specification 959,274; and German unexamined application 23 59 969, in view of the publication "Controlling Cable TV Head Ends and Generating Messages by Means of a Micro Computer" by Robert E. Schloss et al. further in view of the article "Automated Videotape Delay Of Satellite Transmissions" by Jim Chiddix.

Claims 34-36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 3,008,000 in view of German patent application 29 04 981.

Claims 76-81 and 85-90 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,413,281 and German patent application 29 04 981.

Claim 33, 34, 36, 95-97, and 99-102 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over German patent application 29 04 981 in view of U.S. Patent No. 4,398,216 and U.S. Patent No. 3,245,157.

Claims 35 and 98 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over German patent application 29 04 981 in view of U.S. Patent No. 4,398,216 and U.S. Patent No. 3,245,157 further in view of the publication "A Television Facsimile System" by Sueyoshi Soejima.

Claims 2, 3, 5-8, 11-16, 20, 21-23, 37, and 67-69 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Japanese patent publication 55-45248 in view of the article "'Touch-Tone' Teletext A Combined Teletext - Viewdata System" by Gary Robinson and William Loveless.

Claims 2-8, 11, 12-18, 37-41, 67-72, and 85-90 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over British patent specification 1 556 366 in view of the "Mode II"

captioning feature of the “ANTIOPE” teletext standard as discussed in: the article “Development & Applications of the Antiope-Didon Technology” by J. Guillermin; the “CBS/CCETT North American Broadcast Teletext Specification (Extended Antiope)” and the article “Antiope Teletext Captioning” by Claude Sechet.

Claims 2, 3, 5-8, and 11-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the publication entitled “Telesoftware: Home Computing Via Broadcast Teletext” by J. Hedger in view of the publication entitled “A Public Broadcaster’s View of Teletext in the United States” by Hartford Gunn and Gregory W. Harper and British patent 1 405 141.

Claims 2-6, 11-14, and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent 3,961,137 in view of British patent specification 1 556 366.

Claims 2-4, 7, 10, 13-15, and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,675,737.

Claims 2-8, 11-18, 20-23, 37-41, 67-72 and 85-90 stand rejected under 35 U.S.C. 103(a) as being unpatentable over the “Mode II” captioning feature of the ANTIOPE teletext data service in view of computer driven Teletext decoder structure.

Claims 2-8, 11-18, 20-23, 37-41, 67-72, and 85-90 stand rejected under 35 U.S.C. 103(a) as being unpatentable over the publication “The Concept of a Universal ‘Teletext’ (broadcast and interactive Videotex) decoder, microcomputer based” by Bernard Marti in view the Mode II captioning feature of the ANTIOPE teletext standard as described in the “CBS/CCETT North American Broadcast Teletext Specification (Extended Antiope).”

Claims 2-18 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 4,694,490.

## **Argument**

### **1. Introduction**

The majority of the rejections in the Final Office Action were applied for the first time in the Final Office Action. In asserting the few grounds of rejection maintained from the previous

Office action, the Final Office Action does not address appellants' arguments submitted in response to the previous Office action. Appellants filed a "Response To Final Office Action" on October 7, 2004 ("October 2004 Response") fully pointing out the errors in all grounds of rejection, including the new grounds of rejection. The Office has not responded to appellants' response.<sup>1</sup>

## **2. Priority Claim**

### **A. Examiner's Interpretation Of 35 U.S.C. § 120 Is Ripe For Review**

This application was filed June 7, 1995 and claims priority to a chain of seven applications, six of which have issued as letters patent and one of which remains pending. Appellants filed their initial application (No. 317,510) on November 3, 1981. The third application in the priority chain (No. 96,096) was filed September 11, 1987 and includes additional disclosure, explanations, and embodiments. The instant application includes an identical specification to application No. 96,096, with the exception of the claims. Accordingly, it is not disputed that the claims are entitled to an effective filing date of at least September 11, 1987 under 35 U.S.C. § 120. However, the Examiner and appellants disagree as to whether appellants' can claim subject matter disclosed in the 1981 specification and maintain an effective filing date of November 3, 1981 for such claims.

Issues of interpretation of § 120 did not immediately arise in the examination of this application. In the initial Office action, the Office stated that it would not attempt to determine the effective filing date of this application.<sup>2</sup> In response, appellants asserted the 1981 priority date and provided citations to the 1981 specification to support the claims.<sup>3</sup> The Office

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<sup>1</sup> The Office's "Patent Application Information Retrieval" system indicates that the file is marked as lost. The Examiner has informed appellants' representative that he does not have the file, that the marking of the file as lost will facilitate his reception of the file, and that he expects to prepare an advisory action upon reception of the file.

<sup>2</sup> Office action mailed February 13, 1997, p. 2.

<sup>3</sup> Amendment filed August 13, 1997, pp. 11-12.

responded by asserting that the applied art predated the 1981 priority date.<sup>4</sup> Appellants challenged the effective date of the applied art.<sup>5</sup>

The Examiner first asserted that the claims were not entitled to the 1981 effective filing date in the final Office action mailed September 4, 2001 (“Sep. 2001 Office Action”). The Examiner asserted that the disclosure of embodiments described in the 1981 specification were not carried forward into the 1987 specification. (Sep. 2001 Office Action, p. 60 *et seq.*) Based on this assertion, the Examiner has in essence maintained that none of appellants’ claims are entitled to the 1981 priority date. Appellants understand that the Examiner holds the view that no subject matter properly claimed in any of appellants’ copending applications could obtain the benefit of the 1981 effective filing date under § 120. For example, the Examiner stated:

NOTE that if the currently pending amended claims, which are necessarily directed to the “sophisticated” systems/methods of the present 1987 disclosure, were improperly granted the 1981 priority date of their primitive ancestors, then said currently pending claims would effectively become “time machines” for transporting these necessarily recited “sophisticated” systems/methods of applicant’s present 1987 disclosure back in time to the 1981 filing date of their primitive ancestors. Such time travel is not permitted under current U.S. Patent Law.

(Sep. 2001 Office Action, p. 62.)

Appellants filed an “Amendment And Request For Reconsideration Under 37 C.F.R. § 1.116” on February 4, 2002 (“Feb. 2002 Response”) in which appellants set forth the errors in both the Examiner’s legal interpretation of § 120 and his factual assertions regarding the relationship between the 1981 specification and the 1987 specification. Appellants provided extensive arguments and documentation demonstrating that the 1987 specification does in fact include the pertinent disclosure of the 1981 specification. (Feb. 2002 Response, pp. 97-107 and App. C.) In the Feb. 2002 Response, appellants asserted that “an applicant is entitled to priority

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<sup>4</sup> First Final Office Action mailed January 8, 1998 pp. 3-4.

<sup>5</sup> Amendment and Request for Reconsideration Under 37 C.F.R. § 1.111 filed December 29, 1998, pp. 18-19.

under § 120 for any claim if the disclosures in both applications each satisfy the requirements set forth in § 112 for that claim.” (Feb. 2002 Response, p. 92.) Appellants further demonstrated that each claim limitation was supported by both the 1981 and 1987 specifications. (Feb. 2002 Response, App. D.)

The Examiner and appellants’ representatives addressed their differences regarding the proper interpretation of § 120 during an interview held in September 2001. The Examiner issued an advisory action on March 12, 2002 (“Mar. 2002 Office Action”) that purported to summarize the interview. The Examiner did not find appellants showing satisfactory. The Examiner asserted that the demonstration of support for the claimed subject matter in the parent specification was insufficient to demonstrate that the claims are entitled priority to the parent’s filing date. The Examiner asserted that “the same claim can be read on different disclosures within continuing applications and yet the claims of the child still not be entitled to the priority date of the earlier filed parent application [in] a situation in which the terminology of the same claim takes on vastly different meanings/scopes when read in light of the intrinsic evidence that is provided by the different disclosures.” (Mar. 2002 Office Action, p. 7.)

Further prosecution has fully developed the differences between the Examiner’s and appellants’ interpretations of the requirements of § 120. Appellants filed a response on May 6, 2002 that set forth the requirements of § 120 with full citations to the controlling authorities (“May 2002 Response”).<sup>6</sup> The Examiner mailed an Office action on July 30, 2002 (“July 2002 Office Action”) stating that the claims are only entitled to the 1987 effective filing date. Appellants filed a response on January 29, 2003, (“Jan. 2003 Response”) which included an expert declaration of Dr. George T. Ligler (“Ligler Declaration”). The Ligler Declaration demonstrates that the claimed subject matter is sufficiently described in both the 1981 and 1987 specifications from the vantage point of a person of ordinary skill in the art at the relevant time.

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<sup>6</sup> Appellants simultaneously filed a request under 37 C.F.R. § 1.129(a) to withdraw finality of the Sep. 2001 Office Action.

The Final Office Action responds to the Jan. 2003 Response. In the Final Office Action, the Examiner disputes appellants' interpretation of § 120 and, thus, does not consider the Ligler Declaration. (Final Office Action, p. 56.) The Examiner adopts the following position regarding the requirements of § 120:

[T]he steps that applicants must perform to show that a given claim is entitled to the 1981 effective filing date seem straightforward enough. Namely, it appears that applicants need only to:

- i. Identify the respective 1981 and 1987 disclosures that are being relied upon for section 112-1 support of the given claim; and
- ii. Show/explain how and why the so identified 1981 and 1987 disclosures describe/define "the same invention" and therefor constitute "common subject matter" with respect to that which is claimed; i.e. why the respective 1981 and 1987 CIP descriptions are legal equivalents and, therefor, result in identical 1981 and 1987 CIP constructions.

(Final Office Action, p. 56.)

The dispute between the Examiner and appellants regarding the proper requirements of § 120 is ripe for resolution. The Office and appellants have agreed to expedite the prosecution of this application to resolve this dispute. The Office has suspended action in appellants' copending applications in which appellants assert that the claims may be entitled to the 1981 priority date pending resolution of this issue.<sup>7</sup> Accordingly, appellants respectfully request that the proper application of the requirements of § 120 to appellants' priority claims be clearly set forth by the Board of Patent Appeals and Interferences.

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<sup>7</sup> In fact, the Office has issued letters of suspending action in most of appellants' pending applications regardless of the priority claim. The letters, however, assert that this application along with application serial no. 08/470,571 will not be suspended to pursue the issues that have been fully developed. The Office asserts that the resolution of these issues is likely to affect the outcome of each of the suspended applications. Appellants strongly disagree with the decision to suspend prosecution of appellants' copending applications for the reasons set forth in petitions filed under 37 C.F.R. § 1.181 concurrently with this appeal brief in copending applications 08/459,788; 08/487,410; 08/447,447; 08/472,066; 08/487,411; and 08/488,383.



**B. The Requirements of 35 U.S.C. § 120**

Appellants assert that the test to determine whether a claim is entitled to the benefit of an earlier filing date under 35 U.S.C. § 120 is straightforward:

To qualify for an earlier filing date, section 120 requires, *inter alia*, that the earlier-filed U.S. patent application contain a disclosure which complies with 35 U.S.C. § 112, ¶1 for each claim in the newly filed application. Thus, this benefit only applies to claims that recite subject matter *adequately* described in an earlier application, and does not extend to claims with subject matter outside the description in the earlier application. In other words, a claim complies with 35 U.S.C. § 120 and acquires an earlier filing date *if, and only if, it could have been added to an earlier application without introducing new matter.*

*Studiengesellschaft Kohle, m.b.H. v. Shell Oil Co.*, 112 F.3d 1561, 1564, 42 U.S.P.Q.2d 1674, 1677 (Fed. Cir. 1997) (citations omitted; emphasis added).

Section 120 imposes no requirement that a parent and a later filed application use identical or even similar passages to describe the claimed invention. In fact, the case law clearly acknowledges that claims can be supported by disclosures in the earlier and later filed applications in *different* ways:

[T]he earlier and later applications need not use identical words, if the earlier application shows the subject matter that is claimed in the later application, with adequate direction as to how to obtain it. . . . [A]n invention may be described in many different ways and still be the same invention. . . . In *In re Kirchner*, 305 F.2d 897, 904 134 USPQ 324, 330 (C.C.P.A. 1962) the court held that compliance with section 120 does not require that the invention be described in the same way, in both applications.

*Kennecott Corp. v. Kyocera Int'l, Inc.*, 835 F.2d 1419, 1422, 5 U.S.P.Q.2d 1194, 1197 (Fed. Cir. 1987).

In *In re Kirchner*, 305 F.2d 897, 134 U.S.P.Q. 324 (C.C.P.A. 1962), the court addressed a factual scenario similar to the instant scenario. Specifically, in an opinion by Judge Rich, the

C.C.P.A. found that the two disclosures, while different, were not inconsistent and concluded that the applicant was entitled to the priority date of the parent application. At the end of its decision the court described the requirements of § 120:

Assuming the common inventorship, copendency, and cross-reference required by section 120, that section further requires only that the invention be disclosed in the parent application in such manner as to comply with the first paragraph of section 112 and *be* the same invention as that disclosed in the later application. It does not require that the invention be described in the same way, or comply with section 112 in the same way, in both applications.

*Kirchner*, 305 F.2d at 904, 134 U.S.P.Q at 330 (emphasis in original). While the *Kirchner* case focused on the different utilities described in the two applications as required by 35 U.S.C. § 101, the *Kennecott* decision makes it clear that the same logic and analysis is equally applicable to the requirement of written description support under § 112. *See Kennecott*, 835 F.2d at 1422, 5 U.S.P.Q.2d at 1197. Accordingly, these two decisions hold that support from the earlier and later filed applications need not be the same to comply with §§ 112 and 120 even if the earlier application is not incorporated by reference into the later filed application.

### **C. The Errors In The Examiner's Position On § 120 Priority**

A corollary of the proper test set forth above is that “[w]hen [an] earlier application lacks any support in the written description for the new subject matter, the new matter cannot claim priority back to the original filing.” *AK Steel Corp. v. Sollac*, 344 F.3d 1234, 68 U.S.P.Q.2d 1280, 1288 (Fed. Cir. 2003) (Rader, J., concurring). This principle has been expressed in many ways. For instance, the Court of Appeals for the Federal Circuit stated in *Transco Products Inc. v. Performance Contracting Inc.*: “[A]n application is entitled to the benefit of the filing date of an earlier application as to common subject matter.” 38 F.3d 551, 32 U.S.P.Q.2d 1077, 1081.

The Examiner appears to restate this principle as follows:

[A]pplicant must be able to show that the claim construction that results when a given claim is construed under section 112 by the descriptions of the instant 1987 CIP specification, is the same/equivalent claim construction that would have resulted had the same claim been construed under section 112 by the descriptions of the discarded 1981 parent specification; i.e. that the respective 1987 and 1981 descriptions of the claimed subject matter are legal equivalents. Stated another way, applicants' must be able to show that the claims of the instant CIP specification are directed *solely* to "common subject matter" found in both specifications; i.e. that the "claimed subject matter" that is described by the 557 pages of the instant 1987 CIP application in accordance with all of the requirements of section 112 was previously described by the 44 pages of the discarded 1981 parent specification. Stated a third way, applicants must be able to show that the instant application and claims effectively constitutes a "true" CIP application with respect to the 1981 parent application.

(Final Office Action, p. 7.) (emphasis original.) The Examiner appears to restate in three forms the straightforward principle that new matter introduced in a CIP application is not entitled to the benefit of the filing date of an earlier filed application.<sup>8</sup> Appellants see no reason why the Examiner should find it necessary to restate the clear requirements of the controlling authorities on this issue. However expressed, the requirements of § 120 are met by showing that both the 1981 and 1987 specifications contain a disclosure that complies with the first paragraph of § 112 for any pending claim for which the 1981 priority claim is at issue.

At times, however, the Examiner appears to suggest that the requirement that support must come from "common subject matter" is an additional test above and beyond demonstrating support in the earlier and later applications. (*see e.g.* Final Office Action, pp. 9-10.) This additional "test" requires that appellants "[s]how/explain how and why the so identified 1981 and 1987 disclosures describe /define 'the same invention' and therefor constitute 'common subject matter' with respect to that which is claimed." (Final Office Action, p. 56.) The Examiner's rejection of appellants' priority claim appears to be based on appellants' alleged

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<sup>8</sup> The Examiner incorrectly refers to the 1981 specification as "discarded." Appellants have demonstrated that the pertinent disclosure of the 1981 specification is carried forward to the 1987 specification. *See* Feb. 2002 Response, Appendix C.

failure to demonstrate compliance with this additional “common subject matter” test. The Examiner has stated: “[T]he respective ‘correlated’ citations from the 1981 and 1987 specifications that made up applicants’ charts of alleged ‘dual’ support were quite different and did not meet the required ‘common subject matter’/‘same invention’ requirement of section 120.” (Final Office Action, p. 55.)

The Examiner’s additional “common subject matter” test appears to require that limitations of the embodiments disclosed in the specifications be read into the claims. The Examiner queries: “How can applicants cite passages that describe enhanced/improved/expanded 1987 subject matter to support the claims’ limitations under section 112, and then turn around and argue that the claims are really directed to a ‘more basic’ invention that is, allegedly, embedded somewhere within the cited passages to obtain an earlier effective filing date for that which is claimed.” (Final Office Action, pp. 18-19, *see also* pp. 20-21 and 55-56.) This query implies that the Examiner interprets the claims to be limited to an embodiment disclosed in the 1987 specification. Such an interpretation is erroneous. “[I]t is axiomatic that, in proceedings before the PTO, claims in an application are to be given their broadest reasonable interpretation consistent with the specification, and that claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art.” *In re Bond*, 910 F.2d 831, 833, 15 U.S.P.Q.2d 1566, 1597 (Fed. Cir. 1990) (quoting *In re Sneed*, 710 F.2d 1544, 1548, 218 U.S.P.Q. 385, 388 (Fed. Cir. 1983)). *See also In re Bigio*, 381 F.3d 1320, 72 U.S.P.Q.2d 1209, 1211 (Fed. Cir. 2004) (“[T]he PTO gives a disputed claim term its broadest reasonable interpretation during patent prosecution.”); M.P.E.P. § 2111 (8<sup>th</sup> Ed. Rev. 2 2004) (“During patent examination, the pending claims must be given their broadest reasonable interpretation consistent with the specification.”).

It is error for the Examiner to interpret the claims as limited to an embodiment relied upon by appellants to show written description support for the claims. “[I]t is well established that broad claims supported by the written description should not be limited in their interpretation to a preferred embodiment.” *Gart v. Logitech, Inc.*, 254 F.2d 1334, 1343, 59

U.S.P.Q.2d 1290, 1296 (Fed. Cir. 2001) *See also* M.P.E.P. § 2111.01 (8<sup>th</sup> Ed. Rev. 2, 2004) (“One must bear in mind that, especially in nonchemical cases, the words in a claim are generally not limited in their meaning by what is shown or disclosed in the specification.”) It is “recognized that ‘there is sometimes a fine line between reading a claim in light of the specification, and reading a limitation into the claim from the specification.’” *Liebel-Flarsheim Co. v. Medrad Inc.*, 358 F.3d 898, 904, 69 U.S.P.Q.2d 1801, 1806 (Fed. Cir. 2004) (quoting *Comark Communications, Inc. v. Harris Corp.*, 156 F.3d 1182, 1186-87, 48 U.S.P.Q.2d 1001 (Fed. Cir. 1998)). However, the Examiner has clearly crossed this fine line. The Examiner requires that the *disclosures* from the 1981 and 1987 identified by appellants to show support for the claims be shown to be “legal equivalents” and thus “result in identical 1981 and 1987 CIP claim constructions.” (Final Office Action, p. 56.) The Examiner alleges that appellants’ claims fail this “test” because passages of the 1987 specification cited by appellants to support the pending claims include not only the claimed subject matter, but also features that are not claimed in the instant application. This reliance on a comparison of the disclosures of the 1981 and 1987 specifications is improper. As discussed above, Section 120 does not require that the disclosures relied upon to support the claims be the same. What matters is whether or not the *claimed* subject matter is adequately disclosed in both specifications.

“Satisfaction of the description requirement insures that subject matter presented in the form of a claim subsequent to the filing date of the application was sufficiently disclosed at the time of filing so that the *prima facie* date of invention can fairly be held to be the filing date of the application.” In order to determine whether a prior application meets the “written description” requirement with respect to later filed claims, the prior application need not describe the claimed subject matter in exactly the same terms as used in the claims; it must simply indicate to persons skilled in the art that as of the earlier date the applicant had invented what is now claimed. The test is whether the disclosure of the application relied upon reasonably conveys to a person skilled in the art that the inventor had possession of the claimed subject matter at the time of the earlier filing date. “Precisely how close the original description must come to comply with the

description, requirement of Section 112 must be determined on a case-by-case basis.”

*Winter v. Fujita*, 53 U.S.P.Q.2d 1234, 1246-47 (Bd. Pat. App. & Inter. 1999) (quoting *Eiselstein v. Frank*, 52 F.3d 1035, 1040, 34 U.S.P.Q.2d 1467, 1470 (Fed. Cir. 1995)). The correct test is to determine whether the *disclosure* of the earlier application reasonably conveys to a person skilled in the art that the inventor had possession of the *claimed* subject matter at the time of earlier filing date. The claimed subject matter is determined by giving the claims their broadest reasonable interpretation. Thus, assuming the common inventorship, copendency, and cross-reference requirements are met, a claim is entitled to priority under § 120 when, given its broadest reasonable interpretation, the claimed subject matter is disclosed in the earlier and later applications in such manner as to comply with the first paragraph of § 112. If the earlier specification does not disclose the same invention as the later specification, this test will not be met.

The Examiner appears to suggest that his additional “common subject matter” test” is necessary to preclude interpreting claims differently to show both support under § 112 from a later specification and support under § 120 from an earlier specification. (Final Office Action, p. 10.) The Final Office Action includes elaborate hypothetical examples in an attempt to illustrate the necessity of the Examiner’s additional “common subject matter” test. (Final Office Action, pp. 11-15.) However, the Examiner has not shown how a single actual claim element from any of appellants’ claims is subject to such alleged “multiple claim constructions.” Thus, even if the Examiner’s interpretation of § 120 is taken as correct, the Examiner has failed to establish a *prima facie* case of lack of priority under § 120 because no examples of so-called “multiple claim constructions” have been provided.

In contrast, appellants have provided extensive evidence and explanation setting forth in detail the reasons why the claims are entitled to the benefit of the 1981 filing date. In particular, appellants submitted with the Jan. 2003 Response the Declaration of Dr. George T. Ligler

("Ligler Declaration") in accordance with 37 C.F.R. § 1.132.<sup>9</sup> The Ligler Declaration demonstrates that the pending claims are supported by both the 1981 and 1987 specifications. The Examiner identifies no errors in the Ligler Declaration. Rather, the Examiner appears not to consider the Ligler Declaration on the grounds that appellants and the Examiner differ regarding the requirements of § 120. (Final Office Action, p. 56.) The Examiner fails to show how the evidence presented in the Ligler Declaration fails to demonstrate proper priority under any interpretation of § 120. The Examiner only states that:

[I]t is unclear from [applicants' and applicants' expert's] arguments what "standard" of proof applicants and applicants' expert have adopted in support of their conclusions.

(Final Office Action, p. 56.) Appellants note that the Ligler Declaration makes clear that Dr. Ligler

reviewed the standards set forth in Sections 201.11 and 2163 of the Manual of Patent Examining Procedures (MPEP) (8<sup>th</sup> Ed. 2001) in conjunction with 35 U.S.C. §§ 112 and 120 and [] applied the standards set forth in those documents to perform [his] analysis of the written description issue.

(Ligler Declaration, p. 4.) Further, in their Jan. 2003 Response, appellants clearly set forth the proper standards applicable to the requirements of §§ 112 and 120. For example, appellants cited the following case to describe the appropriate standard under § 120:

A claim in a CIP [continuation-in-part] application is entitled to the filing date of the parent application when the claimed invention is described in the parent specification in a manner that satisfies, *inter alia*, the description requirement of 35 U.S.C. § 112.

*Therma-Tru Corp. v. Peachtree Doors Inc.*, 44 F.3d 988, 992, 33 U.S.P.Q.2d 1274, 1276 (Fed. Cir. 1995).

Appellants also cited another Federal Circuit decision setting forth the appropriate standard under the written description requirement of § 112, first paragraph:

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<sup>9</sup> For the convenience of the Board, the Ligler Declaration is attached hereto in the Evidence Appendix.

The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language.

*In re Kaslow*, 707 F.2d 1366, 1375, 217 U.S.P.Q. 1089, 1096 (Fed. Cir. 1983).

Appellants succinctly summarized their understanding regarding the proper standards applicable to §§ 112 and 120:

The proper legal standard for satisfying § 120, as articulated on many occasions by the Federal Circuit, is that the claimed invention must be described in the parent application in a manner that satisfies the terms of § 112.

\* \* \*

The crucial issue for determining if a claim is entitled to the filing date of an earlier application is whether the earlier application shows that the inventor was in possession of the claimed invention as of the date sought under § 120.

(Jan. 2003 Response, pp. 24-25.)

Notwithstanding the above-quoted passages and other discussions of the proper standards for §§ 112 and 120, the Examiner alleges that appellants “have confused the issue of ‘support’ required by § 112 (as incorporated into section 120) with the issue of ‘anticipation’ that exists under § 102.” (Final Office Action, pp. 55-56.) Contrary to the Examiner’s assertion, appellants have never confused or otherwise described the standard for determining whether or not the written description requirement of § 112, first paragraph, is met in terms of an “anticipation” standard. As stated by appellants on numerous occasions, the standard appellants apply for meeting the written description requirement is the standard clearly articulated by the Federal Circuit:

The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language.



*In re Kaslow*, 707 F.2d 1366, 1375, 217 U.S.P.Q. 1089, 1096 (Fed. Cir. 1983). As discussed above, this is also the same standard or test applied by Dr. Ligler in his declaration. (See Ligler Declaration, p. 10.)

**D. The Proper Application Of The Requirements Of 35 U.S.C. § 120**

Claims 2, 3, 4, 7, 10, 13-15, and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 4,675,737 (“Fujino”) issued June 23, 1987. This is the only reference applied in the Final Office Action that has an effective date after appellants’ earliest claimed priority date of November 3, 1981, but before the Sep. 11, 1987 filing date of appellants’ CIP application. Accordingly, the requirements of § 120 need only be applied to claims 2, 3, 4, 7, 10, 13-15, and 17, as there is no dispute that appellants are entitled to the Sep. 11, 1987 filing date of appellants’ CIP application. Appellants respectfully assert that Fujino does not qualify as an available prior art reference as appellants’ asserted priority date predates the effective filing date of Fujino.

Appellants have demonstrated that the subject matter of claims 2, 3, 4, 7, 10, 13-15, and 17 is disclosed in the manner provided by § 112, first paragraph, in the 1981 and 1987 specifications. Accordingly, claims 2, 3, 4, 7, 10, 13-15, and 17 are entitled to the 1981 effective filing date. The Ligler Declaration demonstrates that:

the claimed subject matter of amended claim 2 is disclosed in sufficient detail, in both the 1981 and 1987 specifications, that a person of ordinary skill in the relevant time frames would reasonably understand that the inventor possessed the subject matter of amended claim 2 at the time of filing those specifications.

(Ligler Declaration, p. 10.) The Ligler Declaration also states that all claims depending from claim 2 are similarly disclosed in both the 1981 and 1987 specifications in such a way as to demonstrate to one of ordinary skill in the relevant art that the inventors were in possession of the claimed subject matter at the time each specification was filed. (Ligler Declaration, p. 7.) As discussed above, claim 2 sets forth a method in which a multimedia presentation is output

through the coordination of a presentation, under computer control, using information from a first medium with a presentation of a second medium, whereby the presentation using information in the first medium has a predetermined relationship to the content of the second medium.

The presentation of claim 2 relies on the reception of two media in a plurality of signals. Claim 2 sets forth that a plurality of signals is received. At least a portion of the plurality of signals is received from a source external to the receiver station. The plurality of signals includes at least two media. Both specifications provide support for this claimed step of receiving. Dr. Ligler explained:

In both the 1981 and 1987 specifications, an exemplary “plurality of signals including at least two media” is a first medium containing stock quote information and a second medium being the Wall Street Week television program with embedded instruction and information signals (1981 specification at, e.g., col. 19, ll. 5-8 and ll. 35-41; 1987 specification at, e.g., p. 20, ll. 21-26; and p. 449, ll. 13-20 and ll. 26-35). Both of these media are expressly described as being received by the exemplary user’s receiver station from one or more sources external to that receiver station (1981 specification at, e.g., col. 19, ll. 5-8 and ll. 35-41; 1987 specification at, e.g., p. 20, ll. 20-29; and p. 449, ll. 13-20 and ll. 26-35).

(Ligler Declaration, p. 8.)

The claim further sets forth that the information from a first of the two media is stored. The specifications support this step:

In both the 1981 and 1987 specifications, stock quote information pertinent to a user’s stored stock portfolio is stored at the exemplary receiver station (1981 specification at, e.g., col. 19, ll. 39-41; 1987 specification at, e.g., p. 449, ll. 13-35). While the 1987 specification discloses that the exemplary portfolio information is stored on a floppy disk at the receiver station (1987 specification at, e.g., p. 21, ll. 5-14), this particular method of storing is not recited in amended claim 2.

*Id.*

The content of the second medium received in the plurality of signals is determined. The specifications support this step:

In both the 1981 and 1987 specifications, a program identifier received in advance of the exemplary Wall Street Week broadcast is used to determine content of the Wall Street Week television program (1981 specification at, e.g., col. 19, ll. 12-23; 1987 specification at, e.g., p. 435, l. 23 to p. 436, l. 1). As with the instruction signals discussed . . . below, the 1987 specification describes a more detailed signaling protocol for the program identification signals than is described in the 1981 specification. However, none of these details are recited in amended claim 2.

(Ligler Declaration, pp. 8-9.)

The presentation using the information (from the first medium) is coordinated, at the receiver station under computer control, with a presentation of the second medium based on the step of determining. The specifications support this step:

In both the 1981 and 1987 specifications, the exemplary receiver station prepares, under control of at least exemplary microcomputer 205, a presentation using the stored stock quote information pertinent to the stored stock portfolio of a user of the receiver station. This presentation is a graphic overlay of the user's own stocks' performance to be shown in conjunction with a television-studio-generated graphic of performance of the Dow Jones Industrials (and, in the 1981 specification, of the NASDAQ index as well) within the Wall Street Week television program (1981 specification at, e.g., col. 19, l. 54 to col. 20, l. 2; 1987 specification at, e.g., p. 24, l. 22 to p. 25, l. 8). Both the 1981 and 1987 specifications disclose the preparation of the combined display as involving coordination in time (1981 specification at, e.g., col. 19, ll. 30-34; 1987 specification at, e.g., p. 12, ll. 3-9; and p. 25, l. 33 to p. 26, l. 11). The coordination is based upon the receipt of the Wall Street Week program identifier because receipt of that identifier enables the entire process of generation, coordination, and display of the overlay of the user's own stocks' performance.

(Ligler Declaration, p. 9.)

The multimedia presentation is output to a user at the receiver station based on the step of coordinating such that the presentation using the information (from the first medium) has a

predetermined relationship to the content of the second medium. The specifications support this step:

Finally, both the 1981 and 1987 specifications disclose that, based upon the step of coordinating discussed . . . above, the exemplary overlay of the user's own stocks' performance and the studio-generated graphic of stock index performance received in a transmission of the Wall Street Week television program are simultaneously (a predetermined relationship based on time and content) displayed (1981 specification at, e.g., col. 19, l. 67 to col. 20, l. 2; 1987 specification at, e.g., p. 26, ll. 4-11).

(Ligler Declaration, p. 9-10.)

Accordingly, appellants have demonstrated that both the 1981 and 1987 specifications support the subject matter of claim 2. Appellants respectfully submit that claim 2 is adequately supported by the 1981 specification as demonstrated above. Accordingly, claim 2 is entitled to the benefit of the 1981 priority date. Claims 3, 4, 7, 10, 13-15, and 17 depend from claim 2. Dr. Ligler provides the support for these dependant claims in a chart attached at Tab F to the Ligler Declaration and provides his expert opinion that "[f]rom the vantage point of such a person or ordinary skill in 1981, the claimed subject matter of the . . . claims is sufficiently described in the 1981 specification." For the above reasons Fujino is not available as prior art. Appellants respectfully request that the rejection based on Fujino be reversed for this reason.

Appellants note that the above analysis does not rely on different claim interpretations in order to demonstrate support from both the 1981 and 1987 specifications. To the contrary, the claims are supported in the same way by both specifications. Accordingly, even under the Examiner's unfounded "common subject matter" test, claims 2, 3, 4, 7, 10, 13-15, and 17 are entitled to the benefit of the 1981 filing date. The Examiner has not identified any limitation of claims 2, 3, 4, 7, 10, 13-15, or 17 that is not supported by the 1981 specification. The Examiner has not identified any inconsistencies between the support provided from the 1981 specification and the support provided from the 1987 specification. Accordingly, the Examiner's objections to appellants' priority claim are unfounded.

**3. The Claims Comply With The Requirements Of 35 U.S.C. § 112, First Paragraph**

In Section E2 of the Final Office Action, the Examiner rejects all of appellants' pending claims under 35 U.S.C. § 112, first paragraph, for lack of written description support. Specifically, the Examiner alleges that appellants' 1987 specification does not support the step in claim 2 of "determining content of a second medium received in said plurality of signals." The Examiner's rejection under § 112, first paragraph, should be reversed for several reasons.

First, the Examiner has failed to satisfy his burden to sustain the rejection under § 112, first paragraph. In the July 2002 Office Action, claim 2 was rejected for failure to satisfy the written description requirement of § 112, first paragraph. In rejecting claim 2 under § 112, first paragraph, the Examiner stated that "[i]t is not clear where the disclosure as originally filed disclosed the 'content' of the second medium that is determined in line 9. Clarification is needed." July 2002 Office Action, at p. 98. In response to this rejection, appellants submitted the Ligler Declaration in accordance with 37 C.F.R. § 1.132, which accompanied appellants' Jan. 2003 Response.

The law is clear that examiners must take into account and analyze a declaration submitted by an applicant in response to a rejection under the first paragraph of 35 U.S.C. § 112.

Upon reply by applicant, before repeating any rejection under 35 U.S.C. 112, para. 1, for lack of written description, review the basis for the rejection in view of the record as a whole, including amendments, arguments, and any evidence submitted by applicant. If the whole record now demonstrates that the written description requirement is satisfied, do not repeat the rejection in the next Office action. If the record still does not demonstrate that the written description is adequate to support the claim(s), repeat the rejection under 35 U.S.C. 112, para. 1, fully respond to applicant's rebuttal arguments, and properly treat any further showings submitted by applicant in the reply. When a rejection is maintained, any affidavits relevant to the 35 U.S.C. 112, para. 1, written description requirement, must be thoroughly analyzed and discussed in the next Office action.

M.P.E.P. § 2163.04. *See also In re Alton*, 76 F.3d 1168, 1176, 37 U.S.P.Q.2d 1578, 1584 (Fed. Cir. 1996).

The Examiner has failed to follow the guidelines set forth in the M.P.E.P. First, the Examiner does not challenge, refute, or even acknowledge the Ligler Declaration with respect to this issue. Second, it is clear that the Examiner did not even consider the Ligler Declaration because the Examiner incorrectly asserts that appellants rely on “the described ‘act of detecting’ the overlay command signal” to support the “determining content” step of claim 2. (Final Office Action, p. 59.) However, the Ligler Declaration identifies the use of the *program identifiers* described in both specifications to support the “determining content” step of claim 2. (Ligler Declaration, pp. 9-10) As the Examiner has failed to acknowledge, analyze or discuss the Ligler Declaration’s reasons why the subject matter of claim 2 is adequately supported in appellants’ specifications, the Examiner has not met the burden required to sustain his rejection of claim 2 under § 112, first paragraph.

“To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the invention.” M.P.E.P. § 2163 (8<sup>th</sup> Ed. Rev. 2, 2004). Appellants have demonstrated the support for the step of determining content of a second medium received in the plurality of signals. The Ligler Declaration demonstrates that this limitation of claim 2 is sufficiently described in both the 1981 and the 1987 specifications such that a person of ordinary skill in the art would conclude that appellants invented the subject matter of claim 2 as of the filing date of appellants’ 1981 specification. The Ligler Declaration provides citations to appellants’ 1981 and 1987 specifications precisely pointing out the portions of those specifications that support each and every recited limitation of claim 2. The Ligler Declaration indicates that the step of “determining content of a second medium received in said plurality of signals” is supported by the disclosure of the 1981 specification at e.g., col. 19, ll. 12-23 and the disclosure of the 1987 specification at e.g., p. 435, l. 23 to p. 436, l. 1. Ligler Declaration, at p. 7. Additionally, the Ligler Declaration provides a narrative explanation detailing how claim 2 is supported by the disclosure of each specification. Regarding the “determining content” step, the Ligler Declaration states: “In both the 1981 and 1987 specifications a program identifier received

in advance of the exemplary Wall Street Week broadcast is used to determine content of the Wall Street Week television program.” (Ligler Declaration, at pp. 8-9.) Appellants respectfully request that for these reasons the rejection of claim 2 be reversed.

The Examiner presents arguments regarding whether the specification contains an adequate written description of the step of claim 2 of “determining content of a second medium received in said plurality of signals.” (Final Office Action, pp. 58-59.) The Examiner’s arguments purport to rebut the support provided by appellants in the Jan. 2003 Response for this claim step. However, the Examiner misconstrues appellants’ arguments in the Jan. 2003 Response.

The Examiner erroneously asserts that in the Jan. 2003 Response appellants rely on detection of the overlay command to show determining content in claim 2. (Final Office Action, p. 59.) However, as discussed above, appellants and expert Dr. Ligler have relied on the use of the program identifier to determine the content of the Wall Street Week Television program. The Examiner’s arguments directed to the overlay command signal are moot. The Examiner, thus, has not provided any valid reason to support the rejection under § 112.

The specification does support the term “content” as used in the claims. For example, the specification notes that for mass media “[p]rogram content is the same for every viewer.” (Spec. p. 1, ll. 26-32.) It is this “information content of programming” that is viewed at the receiver station. (Spec. p. 390, ll. 14-23.) As discussed in more detail in Section 5 below, the term “content” is interpreted consistently with the specification to mean “substance, gist, meaning, or significance.” The program identifier cited by Dr. Ligler is used to determine that the received program is in fact the desired Wall Street Week television program. (Spec. p. 435, l. 23 - p. 436, l. 1.) The program identifier is thus used to determine the substance, gist, meaning, or significance of the received television program.

Without elaboration, the Examiner asserts that “support for the ‘content’ terminology in the context of claims 8-10 and 14-16 is, for similar reasons not apparent and/or not understood” and that “clarification regarding support for the ‘content’ terminology is needed as recited in the

context of claims 20, 24, 26, 29, 30, 33, 37, 38, 70, 74, 76, 85, and 95.” The Ligler Declaration identifies the written description support contained in both of appellants’ specifications for each of these claims.<sup>10</sup> Accordingly, for at least the same reasons discussed above with respect to claim 2, the Examiner’s rejections of claims 8-10, 14-16, 20, 24, 26, 29, 30, 33, 37, 38, 70, 74, 76, 85, and 95 should be reversed.

**4. The Claims Are Definite As Required By 35 U.S.C. § 112, Second Paragraph**

In Section E3 of the Final Office Action, the Examiner rejects claims 70-73, and the claims dependent therefrom, as being indefinite for failing to particularly point out and distinctly claim the subject matter appellants regard as their invention. The Examiner asserts that claim 70 is directed to an apparatus, but that the claim includes the following “functional language . . . that is not supported by recitations of corresponding structure”:

wherein said information based on said second medium is generated based on identifying content of said second medium.

(Final Office Action, p. 60.) The Examiner further states that the “structure for providing the recited generation and structure for providing the recited identification of content has not been positively recited as required of an apparatus claim.” *Id.* Contrary to the Examiner’s assertion, it is not improper or otherwise objectionable under § 112, second paragraph, to include descriptions of functions performed by apparatus recited in a claim directed to such apparatus. M.P.E.P. § 2173.05(g). Notwithstanding this fact, appellants note that the recitation that the Examiner objects to is contained in the claim limitation directed to a microcomputer. Accordingly, appellants include in claim 70 (and the claims depending from claim 70) a structure for performing the recited generation and identification in claim 70.

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<sup>10</sup> The Ligler Declaration explains the detailed support provided for the limitations of independent method claims 20 (at p. 13), 24 (at p. 13), 26 (at p. 14), 29 (at p. 14-15), 33 (at pp. 10-12). The support for the remaining claims is identified in the chart at Tab F of the Ligler Declaration.



## 5. The Claims Are Patentable Over The Applied Prior Art

Before turning to the specific claim rejections under 35 U.S.C. §§ 102 and 103, appellants wish to address a claim interpretation error that is repeated by the Examiner throughout the Final Office Action. In particular, the Examiner has erroneously interpreted the term “content.” The phrases “determining content” and “identifying content” of media are thus misinterpreted by the Examiner in a manner that invites rejections based on references that simply disclose detecting portions of transmission signals. For example, many of the rejections are based on television references, with the Examiner taking the position that television synchronization signals constitute “content” of a medium that is determined or identified. For the reasons set forth below, these rejections are based on an *unreasonable* interpretation of “determining content” and “identifying content.” The rejections based on this unreasonable interpretation should be reversed.

M.P.E.P. § 2111 clearly sets forth the manner by which the Examiner should interpret claims during examination. In particular, the pending claims must be “given their broadest *reasonable* interpretation consistent with the specification.” *In re Hyatt*, 211 F.3d 1367, 1372, 54 U.S.P.Q.2d 1664, 1667 (Fed. Cir. 2000) (emphasis added); *In re Bigio*, 381 F.3d 1320, 1324, 72 U.S.P.Q.2d 1209, 1210-11 (Fed. Cir. 2004). This means that the words of the claim must be given their plain meaning unless applicants have provided a clear definition in the specification. *Id.*; *Chef America, Inc. v. Lamb-Weston, Inc.*, 358 F.3d 1371, 1372, 69 U.S.P.Q.2d 1857 (Fed. Cir. 2004). The M.P.E.P. further points out that “plain meaning” refers to the ordinary and customary meaning given to the term by those of ordinary skill in the art. *Sunrace Roots Enter. Co. v. SRAM Corp.*, 336 F.3d 1298, 1302, 67 U.S.P.Q.2d 1438, 1441 (Fed. Cir. 2003); *Brookhill-Wilk I, LLC v. Intuitive Surgical, Inc.*, 334 F.3d 1294, 1298 67 U.S.P.Q.2d 1132, 1136 (Fed. Cir. 2003). The ordinary and customary meaning of a term may be evidenced from a variety of sources, including dictionaries. *Texas Digital Sys., Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1202, 64 U.S.P.Q. 2d 1812, 1818 (Fed. Cir. 2002).

Applying this procedure, an appropriate place to start is with the definition of “content.” Webster’s Ninth New Collegiate Dictionary (1985) defines “content” as follows:

**1****con•tent** \kən-ˈtent\ *adj* [ME, fr. MF, fr. L *contentus*, fr. pp. of *continēre* to hold in, contain — more at CONTAIN] (15c): CONTENTED, SATISFIED

**2****content** *vt* (15c) **1**: to appease the desires of **2**: to limit (oneself) in requirements, desires, or actions

**3****content** *n* (1579): CONTENTMENT <ate to his heart’s ~>

**4****con•tent** \ˈkän-,tent\ *n* [ME, fr. MF, fr. L *contentus*, pp. of *continēre* to contain] (15c) **1 a**: something contained — usu. used in pl. <the jar’s ~s> <the drawer’s ~s> **b**: the topics or matter treated in a written work <the table of ~s> **2 a**: SUBSTANCE, GIST **b**: MEANING, SIGNIFICANCE **c**: the events, physical detail, and information in a work of art — compare FORM 10c **3 a**: the matter dealt with in a field of study **b**: a part, element, or complex of parts **4**: the amount of specified material contained : PROPORTION

The M.P.E.P. provides guidance on what to do when there are several definitions for a term. In particular, the intrinsic record must be consulted to identify which of the different possible definitions is most consistent with applicants’ use of the term. *Renishaw PLC v. Marposs Societa’ per Azioni*, 158 F.3d 1243, 1250, 48 U.S.P.Q.2d 1117, 1122 (Fed. Cir. 1998); *W.E. Hall Co. v. Atlanta Corrugating, LLC*, 370 F.3d 1343, 1348, 71 U.S.P.Q.2d 1135, 1140 (Fed. Cir. 2004).

Appellants’ invention is in the field of telecommunications. The specification notes that for mass media “[p]rogram content is the same for every viewer.” Spec. p. 1, ll. 26-32. It is this “information content of programming” that is viewed at the receiver station. Spec. p. 390, ll. 14-23.

Given the express use of the term “content” in the specification to refer to the information viewed by a user, the logical choice for the definition of “content” in this context is “substance,” “gist,” “meaning” or “significance.” Accordingly, “content” is properly construed to mean “substance,” “gist,” “meaning” or “significance” in contrast to “form” or “structure.” This definition is in accord with the use of the term “content” with the terms “medium” and “media” which connote a channel of communications. Accordingly, the “content” of a medium should be

interpreted to mean the substance, gist, meaning or significance of a channel of communications. The specification provides examples of determining or identifying the substance, gist, meaning or significance of a channel of communications. For instance, program identifiers are used to determine which television program is being transmitted on a particular channel. Spec. p. 435, l. 23 - p. 436, l. 1; p. 252, ll. 31-35. Similarly, other content, such as the closing prices of particular stocks, is identified in other communications. Spec. p. 449, ll. 13-35.

The prior art rejections in the Final Office Action strongly suggest that the Examiner has interpreted the term “determining content” to simply mean “detecting a portion of a transmission signal.” As properly construed, the synchronization signals of a television video signal are not “content” of a medium. Rather the synchronization signals are part of the structure of the underlying electromagnetic signal. In other words, the substance, gist, meaning or significance of what is communicated over the television video signal is independent from the synchronizing pulses. Isolating the line synchronizing pulses does not determine or identify the substance, gist, meaning or significance of the medium (e.g., they do not signify what television program is being provided via the television broadcast). For at least this reason, all rejections premised on the notion that synchronization signals constitute “content” should be reversed.

**6. The Applied Art Does Not Anticipate The Claims Under 35 U.S.C. § 102**

Under 35 U.S.C. § 102, the Office bears the burden of presenting at least a *prima facie* case of anticipation. *Chester v. Miller*, 906 F.2d 1574, 15 U.S.P.Q.2d 1333 (Fed. Cir. 1990); *In re Skinner*, 2 U.S.P.Q.2d 1788-89 (Bd. Pat. App. & Inter. 1986). “A prior art reference anticipates a claim only if the reference discloses, either expressly or inherently, every limitation of the claim.” *Rowe v. Dror*, 112 F.2d 473, 478, 42 U.S.P.Q.2d 1550, 1553 (Fed. Cir. 1997); *see also* M.P.E.P. § 2131. “[A]bsence from the reference of any claimed element negates anticipation.” *Id.* (quoting *Kloster Speedsteel AB v. Crucible, Inc.*, 793 F.2d 1565, 1571, 230 U.S.P.Q. 81, 84 (Fed. Cir. 1986).) “Inherent anticipation requires that the missing descriptive material is necessarily present, not merely probably or possibly present, in the prior art.” *Rosco*

*Inc. v. Mirror Lite Co.* 304 F.3d 1373, 1380, 64 U.S.P.Q.2d 1676, 1680 (Fed. Cir. 2002), *see also* M.P.E.P. § 2112 IV. “In addition, the prior art reference must be enabling.” *Akzo N.V. v. U.S. Int’l Trade Comm’n*, 808 F.2d 1471, 1479, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986); *see also* M.P.E.P. § 2121. That is, the prior art reference must sufficiently describe the claimed invention so as to have placed the public in possession of it. *In re Donohue*, 766 F.2d 531, 226 U.S.P.Q. 619 (Fed. Cir. 1985). “Such possession is effected if one of ordinary skill in the art could have combined the publication’s description of the invention with his own knowledge to make the claimed invention.” *Id*

#### **A. Rejection Based On Turner**

Claims 2-6 and 11-16 stand rejected under 35 U.S.C. § 102(b) as being anticipated by British patent 1 486 424 naming Simon Royce Turner as inventor (“Turner”). Turner relates to a television transmission system for transmitting additional data within the normal television video signal.

##### **i) Independent Claim 2**

In section E-4 of the Final Office Action, claim 2 is rejected as being anticipated by Turner. In claim 2, a multimedia presentation is output through the coordination of a presentation, under computer control, using information from a first medium with a presentation of a second medium, whereby the presentation using information in the first medium has a predetermined relationship to the content of the second medium.

In particular, claim 2 sets forth a step of determining content of the second medium. Turner does not teaching determining the content of any medium. As described in both the 1981 specification and the instant specification, a program identifier is received in advance of the “Wall Street Week” broadcast and is used to identify the information content of the broadcast. The content (the “Wall Street Week” program) of the television broadcast (second medium) is identified.

In contrast, Turner displays character data. Turner p. 2, ll. 29-44. Turner may also display a television picture. Turner p. 2, ll. 38-49. Turner does not teach determining the content of either the character data or the television picture. Turner uses the line synchronizing pulses of the television signal to clock the data bits representing characters into the line blanking interval in the television signal at a rate of only one data bit per television line. Turner, p. 1, ll. 74-91. In the Final Office Action at page 61, a synchronising pulse separator 37 is cited as “determining a sync signal ‘content’ of a second video media.” However as discussed in Section 5 above, the line synchronizing pulse is not the content of either the character data or the television video, nor is it used to determine the content of the character data of the television video.

Claim 2 sets forth coordinating a presentation using the information from the first medium with a presentation of the second medium based on the step of determining. As Turner fails to teach a step of determining as set forth by claim 2, Turner does teach coordinating a presentation based on the step of determining. The applied art simply does not show coordinating a presentation based on determining the content of a television program. There is no teaching to coordinate based on a step of identifying the substance, gist, meaning or significance of the television program.

Claim 2 sets forth outputting the multimedia presentation based on the step of coordinating such that the presentation using the information from the first medium has a predetermined relationship to the content of the second medium. The Final Office Action is silent regarding the relationship between the character data and the content of the television picture of Turner. Turner relates to television transmission systems adapted to transmit additional data within a normal television video signal. Turner discloses improvements to the method of transmitting the data. Turner does not address what the data is or what information the data conveys. Accordingly, Turner does not teach that the data has a predetermined relationship to the content of the television picture. In addition, as Turner does not show a step of coordinating as claimed, Turner does not teach outputting based on the step of coordinating.

For at least the above reasons, appellants request that the rejection based on Turner be reversed.

**ii) Claims Depending From Claim 2**

Claims 3-6 and 11-16 depend from claim 2. In Section E-5 of the Final Office Action, these claims are rejected as being anticipated by Turner. The Final Office Action provides no reasons whatsoever for the rejections of claims 3-5, 11 and 12. Accordingly, a *prima facie* case of anticipation has not been established against these claims. As each of these claims depends from claim 2 and, thus, includes the limitations of claim 2, these claims are not anticipated by Turner for at least the reasons set forth above with regard to claim 2. Appellants respectfully request the reversal of these rejections.

**a) Claim 4**

In addition to the above, claim 4 sets forth that a computer performs the step of determining. As set forth above, the step of determining requires determining the substance, gist, meaning, or significance of the second medium. Turner does not teach any computer that determines the substance, gist, meaning, or significance of the video.

**b) Claims 13-16**

Additionally, claim 13 sets forth that the step of determining comprises processing an identifier. Claim 14 depends from 13 and further sets forth that the identifier identifies the content of the second medium. Claim 15 and 16 depend from claim 14 and set forth that the content of the second medium includes audio and video respectively. In the Final Office Action at page 62, it is asserted, "Sync signals are inherently 'identifiers' of a specific timing content of the TV signal." The content of a television program is not identified by sync signals for the reasons set forth in Section 5 above.

## **B. Rejection Based On Yoshino**

Claim 2 stands rejected under 35 U.S.C. § 102(b) as being anticipated by British patent 1 405 141 naming Hirokazu Yoshino et al. as inventor (“Yoshino”). Yoshino is directed to an electronic calculator that outputs a multiple row display in superposition with television video. Yoshino, like Turner, is merely directed to the display of character data with television video. Yoshino does not anticipate claim 2 for reasons similar to those set forth above with respect to Turner.

As discussed above, claim 2 sets forth a step of determining content of a second medium. Yoshino fails to teach this step. The Final Office Action at page 63 asserts that Yoshino comprised “Circuitry (@ 14) for determining a timing ‘content’ of the received TV signal by detecting sync signals contained therein.” Yoshino includes a synchronizing circuit 14 for supplying the horizontal and vertical synchronizing signals for the display control circuit. Yoshino p. 2, ll. 49-52. As discussed in Section 5 above, detecting sync signals is not determining content of a TV program. For at least this reason, Yoshino does not teach a step of determining content of second medium.

Yoshino does not teach the steps of coordinating and outputting for reasons similar to those set forth above with respect to Turner. As Yoshino does not teach a step of determining as set forth by claim 2, Yoshino does not teach coordinating based on the step of determining. As Yoshino does not teach a step of coordinating as set forth by claim 2, Yoshino does not teach a step of outputting based on the step of coordinating. Furthermore, claim 2 sets forth that the presentation using the information from the first medium has a predetermined relationship to the content of the second medium. Yoshino teaches no predetermined relationship between the image data of the computed information and the television program.

Appellants respectfully request that the rejection based on Yoshino be reversed.

### **C. Rejections Based On Zaboklicki**

Claims 2, 3-18, 20, 21-23, 26, 27, 37-42, 67-69, and 82-84 are rejected under 35 U.S.C. § 102(b) as being anticipated by German patent application 29 04 981 naming Edward Zaboklicki as inventor (“Zaboklicki”).

Zaboklicki is a laid open German application based on a Polish patent application. The Examiner’s original rejections based on Zaboklicki relied on a translation of the German application provided by the Office. (“Schreiber Translation”) That English translation is nearly incomprehensible. In attempt to discern the teaching of Zaboklicki, appellants obtained another translation, which was submitted with the Feb. 2002 Response. (“TransPerfect Translation”) Even with a corrected translation, however, Zaboklicki is a fatally flawed reference. At best, Zaboklicki is an aggregation of desirable features of an interactive television system with no coherent explanation regarding how to implement any particular feature. Zaboklicki lists the components of a television system, but fails to teach how the components operate to provide any particular function. It is not clear what subject matter in Zaboklicki, if any, is disclosed in sufficient detail to have been placed in the public’s possession as is required to be applicable as prior art. M.P.E.P. § 2121.01. The disclosure of Zaboklicki is insufficient to anticipate the instant claims.

The Examiner has taken the non-enabled nature of Zaboklicki as an invitation to fill-in the operational details deemed necessary to allege anticipation of appellants’ claims. In fact, the teaching of Zaboklicki is so vague that the Examiner constructs alternate interpretations of the system purported to be disclosed. (Final Office Action, pp. 66-68.) The details provided by the Examiner are now asserted to anticipate appellants’ claims. The Examiner provides his summary of the alleged showing of Zaboklicki at pp. 65-66 of the Final Office Action. The Examiner’s summary includes no references to any actual teaching of Zaboklicki from either translation. Appellants submit that the lack of citations to the disclosure of Zaboklicki is due to the incomprehensible nature of the Zaboklicki disclosure. Appellants have never acceded to the Examiner’s assertion of the teachings of Zaboklicki.



The Examiner asserts, “[t]he teachings of Zaboklicki must be considered in light of the knowledge (i.e. the state of the art) that existed at the time of applicant’s alleged invention.” (Final Office Action, p. 65). The Examiner again takes the non-enabled nature of Zaboklicki as invitation to use Zaboklicki as a rough outline in which to insert various teachings the Examiner would like to combine in attempt to arrive at the claimed subject matter. At pages 40-52 of the Final Office Action, the Examiner provides a summary of his interpretations of various references. This summary seems to be considered necessary by the Examiner to clarify the teaching that the Examiner desires to find in Zaboklicki: it is not, however, the actual teaching of Zaboklicki nor is the summary prior art. In this summary, the Examiner does not refer to the actual teaching of Zaboklicki from either of the translations. The Examiner refers to various other references to show how the gaps in the teaching of Zaboklicki might have filled in order to arrive at an operative system.

The Examiner rejections are not based on the teaching of Zaboklicki. Rather, the rejections are based on hypothetical systems created by the Examiner that might be arrived at if one skilled in the art attempted to construct an operational system in view of the teaching of Zaboklicki, if such a person had appellants’ disclosures in hand. The Examiner’s constructions are impermissibly guided by appellants’ disclosure. The rejections based on Zaboklicki are thus improper and should be reversed.

**i) Claim 2**

Section E-7 of the Final Office Action rejects claim 2 as being anticipated by Zaboklicki. Zaboklicki, like Turner and Yoshino, fails to teach a step of determining content of a second medium. The Examiner constructs two different two interpretations of Zaboklicki to apply against claim 2. Teletext decoder 56 is relied upon to show “determining content” in both interpretations. In the first interpretation, it is asserted that the teletext decoder is “for determining ‘content’ of other media [i.e., for detecting the page number content of the teletext media; for detecting the control signal content of the teletext media, for detecting program

segment/fragment identifier content of the primary and secondary video/audio components, etc. . . .]” (Final Office Action, p. 67.) In the second interpretation, it is asserted that the teletext decoder is “for determining ‘content’ of other media [i.e., for detecting a ‘telesoftware’ content of the program segments/fragments; for detecting program segments/fragment identifier content of the primary and secondary video/audio components, etc.]” (Final Office Action, p. 68.) A fundamental flaw with both interpretations is that the Zaboklicki reference itself provides no support for these assertions. The Examiner does not point to any teaching of Zaboklicki that ascribes these functions to the teletext decoder 56. Zaboklicki confusingly states, “The text decoder identified by 56 furthermore comprises a circuit 47 to prefilter the characters to control the illumination of the image and an output circuit 48 for characters.” (TransPerfect Translation, p. 9.)<sup>11</sup> The Examiner does not explain how this passage of Zaboklicki (or any other passage of Zaboklicki) supports either interpretation of the functions of text decoder 56.

With regard to determining content of teletext media, Zaboklicki does not disclose such a feature and thus fails to anticipate claim 2. First, the Final Office Action points to no teaching by Zaboklicki that the teletext decoder 56 detects any page numbers, control signal content, or program segment/fragment identifier content. Zaboklicki includes no teaching of this function of decoder 56. Furthermore, in this interpretation, the Final Office Action relies on memory 7 to show storing “telesoftware.” Zaboklicki fails to teach that any telesoftware is stored by memory 7. Furthermore, the Final Office Action is unclear regarding the presentations that are alleged to be coordinated and output when the first interpretation of Zaboklicki is used. Zaboklicki fails to teach that teletext is coordinated with audio or television programming based on determining the content of the teletext.

With regard to determining content of “telesoftware,” there is no teaching in Zaboklicki that any “telesoftware” is a communications medium. When using this alternate interpretation,

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<sup>11</sup> The Schreiber Translation of the same passage is “The text decoder labeled 56 furthermore contains a circuit 47 for prefiltering or prescreening of the symbols for the control of image illumination and an output circuit 48 for symbols.”

the Final Office Action relies on teletext data, audio components and television components to show coordinated presentations. This is inconsistent with the reliance in the Final Office Action on the “telesoftware” to show a second medium. Zaboklicki fails to teach determining content of a second medium which is coordinated with stored information from a first medium, where the presentation using the information has a predetermined relationship to the content of the second medium as set forth in claim 2.

Appellants respectfully request that the rejection of claims 2 as being anticipated by Zaboklicki be reversed for at least the above reasons.

**ii) Claims 3-18**

In Section E-8 of the Final Office Action, claims 3-18 are rejected as being anticipated by Zaboklicki. Claims 3-18 depend from claim 2 and are thus allowable over Zaboklicki for at least the reasons set above with respect to claim 2. The Final Office Action briefly addresses a few selected limitations from certain ones of these dependant claims. Not all the claims are specifically addressed. Furthermore, except for the rejection of claims 3 and 4, it is unclear whether these rejections rely on the first interpretation of Zaboklicki or the second alternative interpretation of Zaboklicki set forth with respect to claim 2. For example, claim 7 sets forth that the content of the second medium explains a significance of the presentation using the information from the first medium. The Final Office Action does not address this claim. Claim 8 sets forth that the content of the second medium explains the significance in audio. The Examiner relies on the secondary audio signal content to show “explanations.” This appears to be inconsistent with the rejection of claim 2 as neither interpretation of Zaboklicki seems to rely on the secondary audio as the second medium. It is unclear what “explanations” the Final Office Action relies upon, as it is unclear what is relied upon to show a first medium from which first information is stored. The Final Office Action merely points to a number of vague features in Zaboklicki, such as audio “explanations,” and attempts to assemble these features in a manner

not taught by Zaboklicki. Accordingly these rejections based on Zaboklicki are improper and appellants request that they be reversed.

**iii) Claim 20**

Section E-9 of the Final Office Action rejects claim 20 as being anticipated by Zaboklicki. Claim 20 sets forth that a multimedia presentation is output through the coordination of a presentation of a first medium and information based on a second medium through the identification of the first and second media. The Final Office Action does not assert that Zaboklicki teaches each limitation of claim 20. Instead, the Final Office Action asserts that the identifiers and step of identification of claim 20 are inherent in Zaboklicki. (Final Office Action, p. 69.) The teaching of Zaboklicki is vague -- there are no details regarding how any of the features touched upon are actually implemented. There is no evidence that Zaboklicki describes an operable system and there is no basis to assert that any particular characteristic is necessary to the Zaboklicki system.

Zaboklicki fails to teach identifying content of a first medium based on an identifier. Zaboklicki fails to teach controlling a receiver station, based on the step of identifying, to enable a coordinated presentation of the first medium and information generated based on identifying content of a second medium. The Final Office Action fails to identify first and second media in Zaboklicki as set forth in claim 20. Appellants submit, therefore, that the Final Office Action fails to establish that Zaboklicki teaches each limitation of claim 20 and that this rejection should be reversed.

**iv) Claims 21-23, 26, 27, 37-42, 67-69 And 82-84**

In Section E-10 of the Final Office Action, claims 21-23 are rejected as being anticipated by Zaboklicki for the same reasons that were set forth for claim 20. In Section E-11 of the Final Office Action, claims 26, 27, 37-42, 67-69 and 82-84 are rejected as being anticipated by Zaboklicki for the same reasons that were set forth for claim 20. No bases for these rejections are set forth in the Final Office Action. As the Final Office Action includes no attempt to show

how Zaboklicki teaches the limitations of these claims, the rejection of these claims is improper. As discussed above, the teaching of Zaboklicki is obscure. The Final Office Action relies on alternate “interpretations” of the reference and relies on matter not set forth in the reference but deemed to be inherent. Accordingly, there is no reasonable way for appellants to discern why the Examiner considers Zaboklicki to teach the limitations of claims 21-23, 26, 27, 37-42, 67-69 and 82-84. Accordingly, the rejections of these claims over Zaboklicki are entirely improper and should be reversed.

#### **D. Rejections Based On Morchand**

In section E-12 of the Final Office Action, claim 33 is rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,008,000 to Charles A. Morchand (“Morchand”).

In claim 33, a multimedia presentation of information included in a first signal received from a remote transmitter station and information included in a second signal is output, whereby a user response is compared to information corresponding to content of the first signal in order to tune the receiver station to receive the second signal.

Morchand contemplates providing an information transfer system that comprises a plurality of sources of information. Selection means at the receiver are operable by the viewer in response to the presented information so that the viewer may select one of the sources. Control means controls the selection means only when the received control function is related to the source selected by the subject. Morchand col. 1, l. 69 - col. 2, l. 10. The control means of Morchand includes photocells 40 in a control unit 26 disposed over predetermined areas of the display tube 42. Morchand col. 2, ll. 59-62. Each photocell is connected to a switch 44 in a selection unit 28 operable by the viewer. Morchand col. 2, ll. 64-68. The output of the switch controls a solenoid 50 in a switching unit 30 that moves a switch 32 of a channel selector 18B. Morchand col. 2, l. 69 - col. 3, l. 1. Accordingly, a viewer response in Morchand is merely holding a selected switch closed at a designated time. During the designated time, flashes of light are incorporated in parts of the picture under the photocells. The channel selector is moved a

number of times equal to the number of flashes at the photocell associated with the selected switch.

Claim 33 sets forth comparing the user response to information corresponding to content of the first signal. The Examiner asserts that the control logic of Morchand is for comparing user responses to information. (Final Office Action, p. 70.) To the contrary, there is no comparison taught by Morchand. Morchand teaches that a particular portion of the video is converted to electrical impulses by a photocell 40 associated with a switch selected by a user. These pulses in an amplified form are used to change the channel of the device. The user merely selects the desired switch that transfers the associated pulses to the channel selector. No information is compared in the Morchand device. The user never has any reason to input or even to know the number of flashes that are broadcast at the appropriate photocell site. Accordingly, there is no user input that is compared to the pattern of light impulses as asserted by the Examiner. As there is no comparison taught by Morchand, Morchand fails to anticipate claim 33. Appellants respectfully request the reversal of this rejection for at least this reason.

**7. The Applied Prior Art Does Not Render The Claims Obvious Under 35 U.S.C. § 103**

A proper rejection under 35 U.S.C. § 103(a) includes the following elements:

- (A) the relevant teaching of the prior art relied upon, . . .
- (B) the difference or differences in the claim over the applied reference(s),
- (C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and
- (D) an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification

M.P.E.P. § 706.02(j). The elements are required to comply with the standard of patentability enunciated by the Supreme Court in *Graham v. John Deere*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966) ("Under § 103, the scope and content of the prior art are to be determined, differences

between the prior art and the claims at issue are to be ascertained, and the level of ordinary skill in the pertinent art resolved.”)

To establish a *prima facie* case of obviousness under § 103, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference to combine the teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references combined) must teach or suggest all of the claim recitations. M.P.E.P. § 706.02(j). Further, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not based on applicants’ disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

In order to support a § 103 rejection based on the modification of a single reference, the Examiner must provide specific evidence to show *why* one of ordinary skill would be motivated to modify the reference in such a way to incorporate all of the claimed elements. *See In re Kotzab*, 217 F.3d 1365, 1370, 55 U.S.P.Q.2d 1313, 1316-17 (Fed. Cir. 2000) (“Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference.”) (emphasis added). Broad conclusory statements concerning motivation to modify, standing alone, are not sufficient to support an obviousness rejection. *See In re Freed*, 425 F.2d 785, 787, 165 U.S.P.Q. 570, 571-72 (C.C.P.A. 1970) (an obviousness rejection must be based on facts, “cold hard facts”); *In re Kotzab*, 217 F.3d at 1370, 55 U.S.P.Q.2d at 1317 (“Broad, conclusory statements standing alone are not ‘evidence.’”). Accordingly, a statement that a modification would be an “obvious design choice,” without factual support, is insufficient as a matter of law. *In re Dembiczak*, 175 F.3d 994, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999), *abrogated on other grounds by In re Gartside*, 203 F.3d 1305, 53 U.S.P.Q.2d 1769 (Fed. Cir. 2000). Finally, as the absence of a suggestion to modify a reference is dispositive in an obviousness determination, a rejection which fails to provide specific evidence as to *why* one of ordinary skill would be motivated to modify the

relevant reference is insupportable, as a matter of law. *See Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 42 U.S.P.Q.2d 1378 (Fed. Cir. 1997).

In order to support a § 103 rejection based on a combination of references, the Examiner must provide a sufficient motivation for making the relevant combinations. *See* M.P.E.P. §§ 2142 and 2143.01; *see also In re Rouffet*, 149 F.3d 1350, 1355, 47 U.S.P.Q.2d 1453, 1456 (Fed. Cir. 1998) (“When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references.”). It is well-settled that an Examiner can “satisfy [the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness] only by showing some *objective teaching* in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988) (emphasis added); *see also In re Lee*, 277 F.3d 1338, 1344, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002) (“‘deficiencies of the cited references cannot be remedied by the Board’s general conclusions about what is ‘basic knowledge’ or ‘common sense’”). As with rejections based on the modification of a single reference, “[b]road conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence [of a motivation to combine]’” and thus do not support rejections based on combining references. *In re Dembiczak*, 175 F.3d at 999, 50 U.S.P.Q.2d at 1617. Without objective evidence of a motivation to combine, the obviousness rejection is the “essence of hindsight” reconstruction, the very “syndrome” that the requirement for such evidence is designed to combat, and without which the obvious rejection is insufficient as a matter of law. *Id.* at 999, 50 U.S.P.Q.2d at 1617-18.

As set forth in greater detail below, the Examiner has failed to follow these requirements when making the § 103 rejections of the claims of the instant application. For this reason alone, the § 103 rejections are improper and should be reversed.



**A. Rejection Based On Barnaby, Okada, And Betts**

Claims 24, 25, 74, 75, 103 and 104 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 3,982,064 to Barnaby (“Barnaby”) in view of Japanese patent publication 56-8975 naming Yashuhito Okada et al. as inventors (“Okada”). Claims 74 and 75 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the three reference combination of Barnaby in view of Okada and further in view of British patent specification 1 556 366 naming William Robert Betts as inventor (“Betts”).

In claim 24, a multimedia presentation of a television program and a second medium is output, whereby information stored at a receiver station is compared to content of a television program to determine whether to present the second medium based on information received from a source different from that of the television program. Claims 25 and 103 depend from claim 24. Claim 74 is an apparatus claim that corresponds substantially to claim 24. Claims 75 and 104 depend from claim 74.

Barnaby sets forth a system in which data is transmitted during the vertical blanking interval of a television signal. In Barnaby, each data line is transmitted during a single line scan period. A first line identifies a page number. In subsequent blanking intervals, data lines are transmitted with a start signal and line address. Barnaby col. 2, ll. 24-34. The Final Office Action has provided only a brief English abstract of the Okada reference. It appears that the Final Office Action relies only on this abstract and the figures of the Okada reference. The abstract asserts that the purpose of Okada is to “obtain a television multiplex character broadcast receiver which can obtain the hard copy of a character broadcast picture without reference to whether the character broadcast picture is projected on a screen.” Betts is directed to a teletext display system for displaying pages of data.

The Examiner’s reliance on the abstract of Okada, rather than a translation of the underlying document, is improper. “If the document is in a language other than English and the examiner seeks to rely on that document, a translation must be obtained so that the record is clear

as to the precise facts the examiner is relying upon in support of the rejection.” M.P.E.P.  
§ 706.02 II.

Claim 24 sets forth a step of comparing first information stored at a receiver station to second information corresponding to content of a television program. Claim 74 likewise sets forth a microcomputer for storing first information and comparing the first information to second information corresponding to content of a television program. In the Final Office Action, it is acknowledged that Barnaby does not suggest these limitations. “Barnaby does not state that the page number input (@ 22) ‘corresponds to content’ of the received TV programming.” (Final Office Action at 73.)

The Examiner takes Official Notice that it was notoriously well known to those of ordinary skill in the art at the time of appellants’ invention for a user to enter page numbers that pertain to “program-related” teletext pages. The Final Office Action includes footnote 33 citing to “Oracle on Independent Television” by Green et al. and PCT publication WO 81/02961. Appellants are uncertain as to whether the casual reference to these publications was intended to form a four or five reference obviousness combination. If so, the rejection should be reversed because the Examiner has failed to properly demonstrate that these four or five references may be combined in accordance with the controlling authorities set forth in Section 7 above. In any event, these two citations demonstrate that systems implementing “program-related” teletext pages were not well known. Both of these references merely contain aspirational statements that text may supplement television programs. No details are provided in either reference. Accordingly, appellants have traversed the Official Notice taken by the Examiner. There is no suggestion that the data of Barnaby is output with the television programming in a coordinated presentation.

Claim 24 further sets forth outputting the television program at a first output device and the second medium at a second output device. Claim 74 likewise sets forth a first output device for outputting the television program and a second output device for outputting the second medium. The Final Office Action acknowledges that Barnaby does not suggest separate output

devices for first and second media. Okada is relied upon to show a printing device. The Final Office Action fails to identify any suggestion or motivation to combine the teachings of Barnaby and Okada. The limited English abstract of Okada relied upon by the Examiner fails to support the broad conclusion that Okada demonstrates that it was known and desirable to those of ordinary skill to have added appropriate selection and switching circuitry to conventional teletext receiving stations to enable users to selectively output received teletext images to a separate output printing device. The Examiner merely asserts that the Okada system is desirable. There is no suggestion to modify the Barnaby system using teachings from Okada.

There is simply no showing or suggestion in the applied art of a user selecting program related teletext pages for printing as suggested by the Final Office Action. The Examiner resorts to relying on an untranslated Japanese application and Official Notice to show these limitations of claims 24 and 74. The only suggestion to combine the above features to result in a user selection of program related teletext pages for printing is found in appellants' specifications.

Claims 25 and 103 depend from claim 24 and, thus, are patentable over Barnaby in view of Okada for the above reasons. Similarly, claims 75 and 104 depending from claim 74 are patentable over Barnaby in view of Okada. Furthermore, claims 103 and 104 set forth that the third information, on which the second medium is based, and the television program are included in first and second channels, respectively, of a multichannel cable transmission. In section E-15 of the Final Office Action, it is merely asserted that it would have been obvious to convey broadcast TV signals of Barnaby and Okada using a multichannel cable system. Even if this unsupported statement was true, it is insufficient to support a rejection of claims 103 and 104. The use of a cable transmission system does not suggest that television programming is included in a first channel while third information providing the basis for a second medium to be coordinated with the television program is included in a second channel.

For at least the above reasons, appellants respectfully request that the rejections of claims 24 and 25 based on Barnaby in view of Okada and claims 74 and 75 based on Barnaby in view of Okada in view of Betts be reversed.

## **B. Rejection Based On Komori And Long**

Claims 26, 27 and 82 stand rejected as being unpatentable over Japanese published application 52-22423 naming Atsushi Komori as inventor (“Komori”) in view of U.S. Patent No. 4,081,990 to Long (“Long”).

In claim 26, a multimedia presentation of information included in one medium and information based on another medium is output, where content of each of the two media is identified and where one of the media is received from a remote transmitter station and the other medium is received from a different source. Claims 27 and 82 depend from claim 26.

The Examiner has provided an untranslated copy of Komori with a brief English abstract. The abstract states that the purpose of Komori is to combine a binary video signal and another video signal by matching their phases. Long is directed to synchronizing unrelated video signals by converting the signals to digital form, storing the digital signals, and then reading out the signals by clocking the signal to a local sync generator.

The Examiner’s reliance on the abstract of Komori, rather than a translation of the underlying document, is improper. “If the document is in a language other than English and the examiner seeks to rely on that document, a translation must be obtained so that the record is clear as to the precise facts the examiner is relying upon in support of the rejection.” M.P.E.P.

§ 706.02 II. The Examiner’s reliance on the abstract of Komori is also insufficient to demonstrate a suggestion or motivation to combine the teachings of the applied references. The Examiner cannot demonstrate that the teaching of Long and Komori are compatible without the precise facts that would be found in the translation of Komori. There is no suggestion to combine the video signals of the Komori system with the Long apparatus or vice versa.

Claim 26 sets forth identifying content of a first and content of a second of a plurality of media. Neither Komori nor Long address identifying content of any television program. The Final Office Action relies on the sync separation circuits of Komori and the clock units of Long to show a video processing device which “[i]dentified . . . a sync signal ‘content’ of the . . . video signal media.” As discussed in Section 5 above, sync signals are not content of media.

Accordingly, Komori and Long both fail to suggest identifying content of a first medium and content of a second medium as set forth by claim 26. Appellants respectfully request the reversal of the rejection of claim 26 based on Komori and Long for at least this reason.

Claims 27 and 82 depend from claim 26 and thus include each limitation of claim 26. Claims 27 and 82 are patentable over Komori and Long for at least the reasons set forth above with respect to claim 26. Claim 82 sets forth that the first medium comprises a television program including video and audio. The Final Office Action asserts at page 76, “One of ordinary skill in the art would have understood the fact that the respective video signals included an audio component processed therewith in a like manner.” There is no such teaching in the applied art. The Komori abstract refers only to video signals. Long relates to “processing video type signals” Long col. 1, l. 6. The Examiner relies specifically on the “sync signal ‘content’” of video signals in Long and Komori. There is no suggestion to process an audio component in a like manner. Applicants respectfully request that the rejection of claims 27 and 82 based on Komori and Long be reversed for at least this reason.

### **C. Rejection Based On Kashigi, Komori And Long**

In section E-18 of the Final Office Action, claims 26-28 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the three reference combination of U.S. Patent No. 4,218,710 to Kazuo Kashigi and Toshitake Koyama (“Kashigi”) in view of Komori and Long.

Kashigi is directed to a digital video effects system. Kashigi discusses combining different television signals by converting analog signals to digital form and then producing a combined signal from the digital data using a reference timing signal.

As discussed above with respect to Komori and Long, claim 26 includes a step of identifying content of a first and content of a second of a plurality of media. Kashigi fails to suggest this step. In the Final Office Action, it is asserted that the Kashigi system identifies a sync signal “content” of “video signal media.” For the reasons set forth in Section 5 above, the mere separation of video sync signals fails to identify the content of the communication medium.

The secondary references to Komori and Long are deficient for the same reasons as discussed above with respect to the rejection based solely on these two references. For at least this reason, appellants respectfully request the reversal of the rejection of claim 26 based on Kashigi in view of Komori and Long.

Claims 27 and 28 depend from claim 26 and thus include each limitation of claim 26. Claims 27 and 28 are patentable over Kashigi in view of Komori and Long for at least the reasons set forth above with respect to claim 26. Appellants respectfully request reversal the rejections of claim 27 and 28 based on Kashigi in view of Komori and Long.

**D. Rejection Based On Marsden, Germany, Diederich,  
Schloss And Chiddix**

Claims 2-6, 11-16, 20-23, 29, 30, 76-81 and 85-94 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over any one of British patent specification 871,238 naming Bernard Marsden as inventor ("Marsden"), British patent specification 959,274 naming Leslie Walter Germany as inventor ("Germany"), and German unexamined application 23 59 969 naming Werner Diederich as inventor ("Diederich") in view of the publication "Controlling Cable TV Head Ends and Generating Messages by Means of a Micro Computer" by Robert E. Schloss et al. ("Schloss"). Claims 17 and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the three reference combination of any one of Marsden, Germany and Diederich in view of Schloss and further in view of the article "Automated Videotape Delay Of Satellite Transmissions" by Jim Chiddix ("Chiddix").

The Final Office Action relies on automated insertion of advertising at local television stations. The Final Office Action describes the Examiner's understanding of such automated systems. (Final Office Action, pp. 79-80) It is asserted that such a "conventional automated" system is illustrated by any one of Marsden, Germany or Diederich. Appellants disagree with the Examiner's summary of the features of "conventional automated" systems for the reasons set forth below. The Examiner's reliance on his summary of "conventional automated" systems, rather the teaching of the cited references, is improper. Marsden is directed to a means for

producing a cue or warning signal for insertion in a television signal. Germany is directed to a cueing system for television. Diederich is directed to an electronic image and tone return apparatus.

i) **Claim 29**

In claim 29, a multimedia presentation of a first medium and a video image is output through processing a control signal at a receiver station which causes execution of processor instructions to create a series of discrete video images, whereby a video image of the series of discrete images is caused to be output after the identification of the first medium.

Particularly, claim 29 sets forth a step of identifying content of a first medium. In the Final Office Action it is asserted that the “conventional automated system” necessarily comprised “[c]ircuitry for receiving and decoding the ‘instruction signal’ that are [sic] embedded within the received network TV programming to ‘*identify content*’ of the network TV programming; i.e., to identify portions/segments of the network TV programming that are to be replaced with local/regional advertising.” As discussed above, the Examiner’s summary of the “conventional automated system” is not prior art and cannot be relied upon as the basis of a proper rejection. Furthermore, the Examiner has not correctly interpreted the term “content” in claim 29. Moreover, it is not clear what signals in the cited art the Examiner relies upon to show “instruction signals.” Regardless, the cited references do not suggest cue signals that identify content of a first medium. As discussed in Section 5 above, the “content” of a medium should be interpreted to mean the substance, gist, meaning, or significance of a channel of communications. The Examiner asserts that the “instruction signals” “identify portions/segments of the network TV programming that are to be replaced with local/regional advertising.” The Examiner does not suggest that the content (i.e., the substance, gist, meaning, or significance) of these portions/segments is identified. To the contrary, as shown in Marsden, the cue signal may indicate a break after which no content is transmitted.

[I]n commercial television programmes . . . it is necessary for the various stations to be advised when a break is about to occur in the

programme, during which the various advertisements are radiated from the various stations, so that no undesirable pauses occur between the programme and the advertisements during which *a viewer is left with a blank screen* on his television receiver.

Marsden p. 1, ll. 30-46 (emphasis added). There is no suggestion in the applied art that any cue signal identifies *content* of a television program.

Claim 29 further sets forth processing a control signal that causes execution of processor instructions to create a series of discrete video images. The Final Office Action acknowledges that the cue signal systems of Marsden, Germany and Diederich do not create a series of discrete video images by processing a control signal. Schloss is relied upon to show this step. Schloss is directed to the use of a microcomputer to control certain functions at the head end of a cable system. The functions include channel switching and character generation. The Final Office Action asserts that the “modified system would have utilized the control ‘computer’ to generate all, or at least some, of the local/regional advertisements that replace the identified portion of the network programming.” There is no such suggestion in the applied art. Schloss does not suggest a control computer that generates local advertisements. Rather, the microcomputer of Schloss merely controls switches which may route advertisements to the proper output channel at a designated time. Schloss does not suggest the creation of local advertisements as suggested in the Final Office Action. Schloss fails to show or suggest processing any control signal that causes execution of processor instructions to create a series of discrete video images.

Furthermore, the Examiner relies on Marsden, Germany and Diederich to show events triggered by cue signal. Schloss uses an event handling program to control switches based on an event file. There is no suggestion that these teachings are interchangeable or combinable. Moreover, neither system identifies content of any medium. For at least these reasons, appellants respectfully request the reversal of the rejection of claim 29 based on Marsden, Germany, or Diederich in view of Schloss.



**ii) Claims 30 And 91-94**

Claims 30 and 91-94 depend from claim 29. Claim 30 is rejected in Section E-19 as being unpatentable over any one of Marsden, Germany and Diederich in view of Schloss. Claims 91-94 are rejected in Section E-21 of the Final Office Action as being unpatentable over any one of Marsden, Germany and Diederich in view of Schloss for the same reasons that were set forth for claims 29 and 30. These dependant claims are patentable over Marsden, Germany or Diederich in view of Schloss for at least the reasons set forth above with respect to claim 29. The rejections of claims 30 and 91-94 are improper, as the Final Office Action does not address the additional limitations of claims 30 and 91-94. Claim 30 sets forth that the step of identifying comprises processing an identifier. The applied art fails to suggest processing an identifier. Claim 92 sets forth that the execution of processor instructions to create a series of discrete video images includes processing data in a second medium. The applied art suggests no such execution of processor instructions including processing data in a second medium. Claim 93 depends from claim 92 and sets forth that the second medium is received in a digital data channel. Claim 94 depends from claim 92 and sets forth a multichannel cable transmission that includes the first medium and a digital data channel including the second medium. The Final Office Action identifies no medium received in a digital data channel and identifies no multichannel cable transmission that includes a digital data channel. For at least these reasons, appellants respectfully request the reversal of the rejections of claims 30 and 91-94 based on Marsden, Germany, or Diederich in view of Schloss.

**iii) Claims 85-90**

Section E-21 of the Final Office Action rejects claims 85-90 over any one of Marsden, Germany and Diederich in view of Schloss for the same reasons that were set forth for claims 29 and 30. Claim 85 is an apparatus claim that is generally analogous to method claim 29. Claims 86-90 correspond generally to claims 30 and 91-93 respectively. These claims are patentable over Marsden, Germany and Diederich in view of Schloss for at least the reasons set forth above with respect to claim 29.

Claim 85 sets forth a microcomputer for creating a series of discrete video images by executing processor instructions based on processing a control signal, identifying content of a first medium, and then causing a video image of the series of discrete video images to be output. The applied art suggests no microcomputer for creating a series of discrete video images by executing processor instructions based on processing a control signal for the reasons set forth above with respect to claim 29. The applied art suggests no microcomputer for identifying content of a first medium for the reasons set forth above with respect claim 29. Claims 86-90 are patentable over Marsden, Germany and Diederich in view of Schloss for at least the reasons set forth above with respect to claims 30 and 91-93. Appellants, therefore, respectfully request the reversal of the rejection of claims 85-90 based on Marsden, Germany, or Diederich in view of Schloss.

**iv) Claims 2-6, 11-16, 20-23, And 76-81**

Claims 2-6, 11-16, 20-23 and 76-81 are rejected in Section E-21 of the Final Office Action as being unpatentable over any one of Marsden, Germany and Diederich in view of Schloss for the same reasons that were set forth for claims 29 and 30. Claims 2, 20 and 76 are independent claims. Claims 3-6 and 11-16 depend from claim 2. Claims 21-23 depend from claim 20. Claims 77-81 depend from claim 76. The Final Office Action presents no explanation of the rejection based on Marsden, Germany, Diederich and Schloss against these claims. Accordingly, the Final Office Action fails to establish a *prima facie* case of obviousness against these claims. As the Final Office Action fails to provide any reasoning demonstrating how Marsden, Germany, Diederich and Schloss render these claims obvious, it is impossible to point out the errors in the Examiner's reasoning. As discussed above, there is no suggestion that the teachings Marsden, Germany, or Diederich are interchangeable or combinable with the teachings of Schloss as the former show events triggered by cue signals while Schloss uses an event handling program to control switches based on an event file. Appellants respectfully request that this rejection be reversed for at least these reasons.

Appellants note that at least the following limitations of these claims are not suggested by the applied references.

With regard to claim 2, the applied references fail to suggest determining content of a second medium. The applied references also fail to suggest storing information from a first medium. The applied references further fail to suggest a presentation using stored information from a first medium that has a predetermined relationship to the content of the second medium.

With regard to claim 20, the applied references fail to suggest receiving a first signal including an identifier or identifying content of a first medium based on the identifier. The applied references also fail to suggest controlling the receiver station to enable a coordinated presentation of the first medium and information based on the second medium, wherein, the information based on the second medium is generated based on identifying content of the second medium.

With regard to claim 76, the applied references fail to suggest a microcomputer for identifying content of a first medium and identifying content of a second medium.

**v) Claims 17 And 18**

Claims 17 and 18 are rejected in Section E-22 of the Final Office Action as being unpatentable over the three reference combination of any one of Marsden, Germany and Diederich in view of Schloss and further in view of Chiddix. Claim 17 depends from claim 2 and sets forth storing the second medium at the receiver station. Claim 18 depends from claim 17 and sets forth that the second medium comprises television and the first medium is received in a digital data channel of a multichannel cable transmission including the second medium.

The Final Office Action apparently acknowledges that Marsden, Germany, Diederich and Schloss do not suggest the additional limitations set forth in claims 17 and 18. The Final Office Action asserts that Chiddix is cited to show recording TV programming for delayed rebroadcast. However, there is no showing of how the cited art teaches or suggests the elements of claim 2 as discussed above. Accordingly, it is unclear how the use of tape delayed broadcasts shows the

elements of claims 17 and 18. For example, as the Final Office Action fails to identify a first medium and second medium as recited in claim 2, appellants cannot reasonably ascertain how the Examiner applies Chiddix in combination with the four other applied references to show a step of storing a second medium as set forth by claim 17. Similarly, appellants cannot reasonably ascertain how the Examiner applies Chiddix to show a digital data channel of a multichannel cable transmission including the second medium as set forth by claim 18. Accordingly, appellants respectfully request that the rejection of claims 17 and 18 based on Marsden, Germany, or Diederich in view of Schloss and further in view of Chiddix be reversed.

#### **E. Rejection Based On Morchand And Zaboklicki**

Claims 34-36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Morchand in view of Zaboklicki. Claims 34-36 depend from claim 33. Morchand fails to suggest each element of claim 33 for the reasons set forth in Section 6.D above. Zaboklicki fails to correct the deficiencies of Morchand as applied against claim 33. Claims 34-36 are patentable over Morchand and Zaboklicki for at least this reason.

The Final Office Action acknowledges that the limitations set forth in claims 34-36 are not suggested by Morchand. (Final Office Action, p. 84.) The Final Office Action merely asserts that these features are present in the Zaboklicki reference and thus it would have been obvious to modify the Morchand system to include these features. There is no suggestion or motivation found in the prior art to modify Morchand based on the obscure disclosure of Zaboklicki. No such suggestion or motivation has been identified by the Examiner. Accordingly, the Examiner has failed to establish a prima facie case of obviousness based on the combination of Morchand and Zaboklicki and the rejection should therefore be reversed.

Claim 34 sets forth transmitting information from the receiver station based on the step of receiving the user response. Claim 36 depends from claim 34 and sets forth that the transmitted information is transmitted by telephone. The Final Office Action notes that figure 4 of Zaboklicki shows conveying user responses to a remote location via the telephone line.

However, there is no suggestion that such transmission would benefit the Morchand system in any manner. In the Morchand system, alternative programming is transmitted on alternate channels. The user input is used to tune to the appropriate channel. There is no suggestion of how the user input *if* transmitted to a remote location would be used by the Morchand system. There is no benefit or reason to modify Morchand to transmit the user response from the receiver station. Accordingly, there is no motivation to combine any teaching of Zaboklicki with the teaching of Morchand as suggested in the Final Office Action.

Claim 35 sets forth that the information in the second signal is output to a printer. The Final Office Action at pages 84-85 asserts, “Zaboklicki evidences the fact that it was known to have been desirable to provided [sic] the receiver in such systems a printing capability.” Appellants maintain that at best, Zaboklicki asserts the desirability of a host of features, but fails to provide the details to enable a system that actually provides the features relied upon in the Final Office Action. Furthermore, there is no suggestion to combine any printing capability that may be shown in Zaboklicki with the teaching of Morchand. Morchand is directed to switching from one television channel to another television channel based on switches activated by the viewer. A printing capability would have no function in the Morchand system, which merely outputs television programs. For at least the above reasons, appellants respectfully request the reversal of the rejection of claims 34-36 based on Morchand in view of Zaboklicki.

#### **F. Rejection Based On Thonnart And Zaboklicki**

Claims 76-81 and 85-90 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,413,281 to Paul Thonnart (“Thonnart”) and Zaboklicki.

Thonnart is directed to the creation of a series of text pages, images scans, and voice commentaries through a composition device at a studio. The text pages, image scans and voice commentaries are transmitted for successive reproduction at a point of reception. Thonnart col. 2, ll. 25-46.

**i) Claim 76**

Section E-25 of the Final Office Action sets forth a rejection of claim 76 as being unpatentable over Thonnart and Zaboklicki. Claim 76 sets forth a multimedia presentation apparatus. The apparatus as claimed includes two receivers for receiving a first and a second medium, respectively. The claimed apparatus also includes a microcomputer for identifying content of the first medium and identifying content of the second medium and controlling, based on the identified content, a multimedia presentation comprising information included in the first medium and information based on the second medium. The claimed apparatus further includes an output device for outputting the multimedia presentation. Neither Thonnart nor Zaboklicki show or suggest a microcomputer as set forth by claim 76.

The Final Office Action acknowledges that Thonnart does not show or suggest such a microcomputer. However, neither Zaboklicki nor Thonnart show a microcomputer for identifying content of a first medium and identifying content of a second medium. The Final Office Action at page 85 asserts that the interactive systems of Thonnart and Zaboklicki include “added program segment/fragment identifiers to transmitted program segments/fragments in order to have allowed the receiver station to find and identify those of the transmitted segments/fragments that it needs for its given user specific presentation.” This assertion is insufficient to demonstrate identifying content of both a first and a second media and controlling, based on identifying the content, a multimedia presentation.

The Final Office Action points to no teaching from Zaboklicki or Thonnart where “program segment/fragment identifiers” are used to identify content of multiple media received on multiple receivers and controlling a multimedia presentation based on the identification. Zaboklicki fails to show or suggest multiple media received on multiple receivers. Thonnart discloses transmission of a presentation of a series of pages of teletext, images, and audio commentaries arranged together in a fixed format by a composition device, 6, at a studio. Thonnart, col. 2, ll. 27-36, fig. 1. Thonnart discloses that identifying messages are used to detect image and sound components of the presentation for transmission to memory. Thonnart col. 3,

II. 39-49. However, Thonnart includes no microcomputer for identifying content of multiple media and controlling, based on identifying content, a multimedia presentation. In Thonnart, the teletext, images, and audio commentaries are simply passed to memory to be reconstituted in the form composed at the studio. Thonnart discloses no apparatus equivalent to the microcomputer set forth in claim 76. There is no suggestion in Thonnart to control a multimedia presentation at the point of reception based on identifying content of multiple media. There is, therefore, no suggestion to modify Thonnart to include a microcomputer for controlling a multimedia presentation based on identifying content of multiple media.

There is no suggestion or motivation to modify Thonnart to include a microcomputer that identifies the content of multiple media and controls a multimedia presentation based on such identification. No such suggestion or motivation has been identified by the Examiner. There is no showing or suggestion of such a microcomputer by Zaboklicki as asserted in the Final Office Action. There is, therefore, no suggestion to modify Thonnart to include a microcomputer as suggested by the Examiner. For at least these reasons, the combination of Zaboklicki and Thonnart fails to show or suggest a microcomputer as set forth by claim 76. For at least the above reasons, appellants respectfully request that the rejection of claim 76 based on Thonnart and Zaboklicki be reversed.

**ii) Claims 77-81**

Claims 77-81 depend from claim 76 and are referenced in Section E-25 of the Final Office Action, which sets forth the rejection of claim 76. However, the additional limitations set forth by claims 77-81 are not addressed in Section E-25. Accordingly, the Final Office Action fails to set forth a *prima facie* case of obviousness against these dependent claims. Claims 77-81 are patentable over Thonnart and Zaboklicki for at least the reasons set forth above with respect to claim 76. Applicants respectfully request that the rejections of claims 77-81 based on Thonnart and Zaboklicki be reversed.

Furthermore, claim 78 sets forth that the microcomputer controls storage of the first medium. Claim 78 depends from claim 77, which sets forth that the microcomputer controls storage of the information based on the second medium. Thonnart and Zaboklicki fail to show or suggest a microcomputer that controls storage of a first medium and storage of information from a second medium and controls a multimedia presentation comprising information included in the first medium and information based on the second medium.

Claim 79 sets forth that the first medium includes a television program including video and audio. Claim 79 depends from claim 76. As discussed above, claim 76 sets forth a microcomputer for identifying content of the first medium. Neither Zaboklicki nor Thonnart shows or suggests identifying content of a first medium including a television program including video and audio.

### **iii) Claims 85-90**

Section E-26 rejects claims 85-90 as being unpatentable over Thonnart and Zaboklicki for the same reasons that were set forth for claims 76-81. No explanation is provided to support this rejection. Claim 85 is an independent apparatus claim. Claims 86-90 depend from claim 85. As the Final Office Action fails to consider any of the limitations set forth by these claims, a *prima facie* case of obviousness has not been established.

Claim 85 sets forth a microcomputer for creating a series of discrete video images by executing processor instructions based on processing a control signal, identifying content of a first medium, and then causing a video image of the series of discrete video images to be output. The Final Office Action is wholly silent regarding where the applied art shows a microcomputer for creating a series of discrete video images based on processing a control signal. For at least the above reasons, the Final Office Action fails to demonstrate that each element of claim 85 and claims 86-90 dependent therefrom are shown or suggested by Thonnart or Zaboklicki either singly or in any proper combination. Applicants respectfully request the reversal of the rejection of claims 85-90 based on Thonnart and Zaboklicki.



**G. Rejections Based On Zaboklicki, Field, Laviana And Soejima**

Claims 33, 34, 36, 95-97 and 99-102 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the three reference combination of Zaboklicki in view of U.S. Patent No. 4,398,216 to Robert W. Field et al. (“Field”) and U.S. Patent No. 3,245,157 to Donald W. Laviana (“Laviana”). Claims 35 and 98 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the four reference combination of Zaboklicki in view of Field and Laviana for the same reason as set forth for claim 95, further in view of the publication “A Television Facsimile System” by Sueyoshi Soejima (“Soejima”).

**i) Claim 95**

In Section E-27 of the Final Office Action, claim 95 is rejected over Zaboklicki in view of Field and Laviana. Claim 95 sets forth a multimedia presentation apparatus. The apparatus presents a multimedia presentation of information included in a first signal received at a first receiver at a first output device and information received in a second signal at a second output device. A microcomputer receives a user response and compares the response to information corresponding to content of the first signal in order to tune the second receiver to receive the second signal.

In the Final Office Action, it is asserted that claim 95 differs from Zaboklicki in that circuit 43 of Zaboklicki does not explicitly show an audio tuner. Appellants assert that this is not the sole difference between claim 95 and Zaboklicki.

Zaboklicki fails to show or suggest a microcomputer for receiving a user response based on outputting a first signal, comparing the user response to information corresponding to content of the first signal, and based on the comparison tuning the second receiver to receive the second signal. The Final Office Action asserts that elements 6, 7, 34, 39 and 49 of Zaboklicki inherently compare user entered responses to information of an interactive programming script. This assertion is insufficient to establish a *prima facie* case of obviousness.

As discussed above, the disclosure of Zaboklicki is obscure. This obscure disclosure includes no inherent teaching of a microcomputer that performs a comparison as set forth by claim 95. In claim 95, a receiver receives a first signal and the microcomputer receives a user response based on outputting the first signal. The user response is compared to information corresponding to content of this first signal. The Examiner asserts that various components of Zaboklicki, the functions of which are not discussed, together form a microcomputer that inherently functions to compare user entered responses to information of an interactive programming script. It is unclear what the term "interactive programming script" refers to in the Final Office Action. Indeed, the term appears nowhere in the reference. Regardless, Zaboklicki shows no signal that is received and output that includes content to which a user response is compared.

Zaboklicki fails to show both a first receiver for receiving a first signal and a second receiver for receiving a second signal, where the first signal is output at a first output device and the second signal is output at a second output device. The Final Office Action relies on receiver 54 to show all of these elements. There is simply no showing of multiple devices for outputting different received signals in Zaboklicki. The Final Office Action relies on the "portion of TV receiver (54) . . . of Zaboklicki that receives the multi-channel TV signals" to show the first receiver. The CRT and speaker of the receiver 54 are relied upon to show first and second output devices. However, there is no suggestion in Zaboklicki that "multi-channel TV signals" are output by the CRT and not the speaker. The CRT and speaker of receiver 54 are not multiple independent output devices as suggested by Final Office Action. Even if the speaker and CRT are considered to be independent output devices, there is no suggestion that the user response is based on outputting a first signal *at the CRT*. As discussed above, there is no suggestion that the user response is compared to information corresponding to content of the signal *output at the CRT*. Zaboklicki simply does not suggest first and second receivers as set forth by claim 95.

The secondary references to Field and Laviana fail to correct for the deficiencies of Zaboklicki as applied to claim 95 set forth above. The Final Office Action relies on the

secondary references to show tuning to an audio channel. There is no suggestion or motivation to combine the disclosure of Zaboklicki with the disclosure of the secondary references. The Examiner recognizes that the disclosure of Zaboklicki is not explicit. The Examiner attempts to fill-in the holes in the Zaboklicki disclosure with the secondary references. The incompleteness of the disclosure of Zaboklicki is not itself a motivation or suggestion to combine other teachings with the Zaboklicki disclosure. Accordingly, the Examiner has not identified a motivation or suggestion to combine the disclosures of Zaboklicki, Field, and Laviana as suggested in the Final Office Action. However, even if it is assumed that Zaboklicki can be modified to tune to selected audio channels, Zaboklicki does not show every element of claim 95 for the reasons set forth above. Appellants respectfully request the reversal of this rejection of claim 95 based on Zaboklicki in view of Field and Laviana.

**ii) Claims 96, 97, 99 And 100**

In Section E-28 of the Final Office Action, claims 96, 97, 99 and 100 are rejected as being unpatentable over Zaboklicki in view of Field and Laviana for the same reasons that were set forth for claim 95. Claims 96, 97, 99 and 100 depend from claim 95. The Final Office Action fails to present a *prima facie* case of obviousness against these claims. The Final Office Action does not address any of the limitations set forth by these claims. The Final Office Action merely states, "With respect to the claims 96 and 97, note figure 4 of Zaboklicki." Figure 4 of Zaboklicki purports to illustrate a circuit that transmits viewer responses to memory of the central processor. There is no explanation how the circuit of figure 4 transmits information from a microcomputer as set forth by claim 96. These claims are patentable over Zaboklicki in view of Field and Laviana for at least the reasons set forth above with respect to claim 95. Accordingly, appellants respectfully request the reversal of this rejection.

**iii) Claims 33, 34, 36, 101 And 102**

Section E-29 rejects claims 33, 34, 36, 101 and 102 as being unpatentable over the three reference combination of Zaboklicki in view of Field and Laviana for the same reasons set forth

for claims 96, 97, 99 and 100. There is no explanation provided setting forth any of the elements of a proper rejection under § 103 with respect to these claims. Accordingly, the Final Office Action fails to establish a *prima facie* case of obviousness against these claims. Claim 33 sets forth a method that could be performed by the apparatus of claim 95. Claims 34, 36, 101 and 102 depend from claim 33. Zaboklicki fails to suggest all the elements of these claims for reasons similar to those set forth above with respect to claim 95. For example, Zaboklicki does not include sufficient details to suggest comparing a user response to information corresponding to content of a first signal as set forth in independent claim 33. For at least these reasons, appellants respectfully request that the rejections of claims 33, 34, 36, 101, and 102 based on Zaboklicki in view of Field and Laviana be reversed.

**iv) Claims 35 And 98**

Section E-30 of the Final Office Action rejects claim 98 as being unpatentable over the four reference combination of Zaboklicki in view of Field and Laviana for the same reason that was set forth for claim 95, further in view of Soejima. Claim 98 depends from claim 95 and sets forth that the second output device comprises a printer. Section E-31 of the Final Office Action rejects claim 35 as being unpatentable over the four reference combination of Zaboklicki in view of Field and Laviana for the same reason that was set forth for claim 33, further in view of Soejima. Claim 35 sets forth that the second signal is output at a printer. Soejima is relied upon to show transmission of a facsimile signal on the television sound signal.

There is no motivation in the cited art to combine the applied references in the manner suggested in the Final Office Action. Laviana is applied to show tuning to alternate audio channels. Soejima is applied to show transmitting facsimile data in an audio channel. There is no suggestion in either reference to selectively tune an audio channel to receive text data. The reception of facsimile data is not compatible with the audio visual teaching system of Laviana. Soejima does not suggest the selective output of facsimile data with a presentation of television programming. The vagueness of the primary reference of Zaboklicki does not serve to salvage

this rejection. A prime example of the non-enabling disclosure of Zaboklicki is the operation of printer 37. Zaboklicki includes a single sentence that notes that numeral 37 designates a printer. Schreiber Translation, p. 15. There is no further disclosure regarding the operation or function of the printer within the Zaboklicki system. There is simply no teaching in Zaboklicki regarding what the printer outputs. The numerous voids in the disclosure of Zaboklicki are not an invitation to the Examiner to use appellants' claims as a guide to attempt to explain how the Zaboklicki system may have functioned. None of the applied art suggests printing information from a second signal received based on a user response to content of a first signal. The only motivation to ascribe such a function to printer 37 of Zaboklicki is found in the appellants' specifications. For the above reasons, appellants respectfully request that the rejection of claims 35 and 98 based on Zaboklicki in view of Field and Laviana and further in view of Soejima be reversed.

#### **H. Rejection Based On Tsuboka And Robinson**

Claims 2, 3, 5-8, 11-16, 20, 21-23, 37 and 67-69 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Japanese patent publication 55-45248 naming Hidekazu Tsuboka et al. as inventors ("Tsuboka") in view of the article "'Touch-Tone' Teletext A Combined Teletext - Viewdata System" by Gary Robinson and William Loveless ("Robinson"). Tsuboka is directed to a character data receiving unit. Robinson proposes a teletext system in which a viewer can request a page over the telephone and receive the page over the air for display on a television set.

##### **i) Claim 2**

As discussed above, claim 2 sets forth that a multimedia presentation is output through the coordination of a presentation, under computer control, using information from a first medium with a presentation of a second medium, whereby the presentation using information in the first medium has a predetermined relationship to the content of the second medium.

The Final Office Action asserts that claim 2 differs from the showing of Tsuboka only in that Tsuboka did not indicate a process in which the coordinated display of teletext/viewdata and

video was produced based on a determined content of the TV programming. This is not the only difference between claim 2 and Tsuboka. For example, claim 2 sets forth outputting the multimedia presentation to a user based on the step of coordinating such that the presentation using the information from the first medium has a predetermined relationship to the content of the second medium. Tsuboka includes no suggestion to coordinate presentations to output a multimedia presentation such that any text data has a predetermined relationship to the content of any TV program.

There is no suggestion in Tsuboka of a step of determining content of a second medium. The Final Office Action takes Official Notice that it was notoriously well known to those of ordinary skill in the art for conventional teletext services to have carried “program-related” teletext pages. The Examiner has taken similar Official Notice in the rejection based on Barnaby in view of Okada and Betts discussed above. The art referred to by the Examiner demonstrates that systems implementing “program-related” teletext pages were not well known, but rather were merely at the beginning stages of being considered. No details of such a system are provided in the cited art. The Final Office Action, however, does not rely on this Official Notice in this rejection, rather, the rejection relies on Robinson. Appellants traverse the Official Notice to the extent that the Examiner seeks to establish details of distributing “program-related” teletext not disclosed by Robinson.

Robinson states, “Viewers could get the latest details on breaking stories or more detail on stories that interest them. News programs on television could refer a viewer to these pages to get the detail that is cut out due to time limitations.” Robinson at 300. The Examiner asserts that in accessing such a page, the user inherently selected the program-related videotex page by determining content of the TV program medium. It is asserted, “the user determines that the content of the TV programming contains explicit reference to (i.e., an ‘identifier’ of) the program-related teletext page that was to be selected by the user.” There is no such teaching in Robinson. Robinson includes no teaching that news programs would include individual references to page identifiers of related content. The TV news program rather refers generically

to the teletext system where additional detail is available. There is no teaching that the viewer uses an explicit reference to an identifier to access the material in the teletext system. Accordingly, there is no suggestion by Tsuboka or Robinson of a step of determining content as set forth by claim 2. Appellants respectfully request that this rejection of claim 2 be reversed.

**ii) Claims 3, 5-8 And 11-16**

Claims 3, 5-8 and 11-16 are rejected in Section E-33 of the Final Office Action as being unpatentable over Tsuboka and Robinson for the same reasons that were set forth for claim 2. The Final Office Action fails to address the limitations of these claims and, thus, the Final Office Action fails to set forth a *prima facie* case of obviousness against these claims. As claims 3, 5-8 and 11-16 depend from claim 2, these claims include each limitation of claim 2 and are patentable over Tsuboka and Robinson for at least the reasons set above with respect to claim 2. Appellants respectfully request that the rejections of claims 3, 5-8, and 11-16 based on Tsuboka and Robinson be reversed for at least this reason.

**a) Claims 13-16**

In addition to the above, claim 13 sets forth that the step of determining comprises processing an identifier. Claims 14-16 depend from claim 13. The Examiner acknowledges that Tsuboka does not show the step of determining. As discussed above with respect to claim 2, there is no identifier shown or suggested by Robinson. Moreover, even if the teaching of Robinson is modified to include a reference to a specific teletext page, there is no suggestion that such a reference be processed in the Robinson system to determine content of the TV program. To the contrary, the Examiner relies on the user to determine the content of the TV program. Any such “user determination” does not include processing an identifier to determine content of the TV program. Claim 14 sets forth that the identifier identifies the content of the second medium. Robinson includes no suggestion of an identifier that identifies the content of the TV program.

**iii) Claim 20**

Section E-34 rejects claim 20 as being unpatentable over Tsuboka in view of Robinson. Claim 20 sets forth that a multimedia presentation is output through the coordination of a presentation of a first medium and information based on a second medium through the identification of the content of the first and second media.

Tsuboka and Robinson fail to suggest a step of receiving a first signal including an identifier. The Final Office Action asserts that claim 20 is rejected for the same reason set forth for claim 2. As discussed above with respect to claim 2, the Final Office Action erroneously asserts that Robinson discloses a TV program having an identifier therein. There is no teaching in Robinson that any TV program includes an explicit reference to a particular program-related videotext image as asserted in the Final Office Action.

Claim 20 further sets forth identifying content of the first medium based on the identifier. The Final Office Action asserts that the user “processed the identifier to identify ‘content’ of the TV programming (i.e., the user processed the explicit reference contained therein to identify the page number of the program-related videotext page that is to be inputted/selected by the user.)” Neither Tsuboka nor Robinson suggest page numbers transmitted in TV programming as suggested by the Final Office Action. Furthermore, there is no suggestion that any such page numbers would identify content of the TV programming as asserted in the Final Office Action.

Claim 20 sets forth that information based on a second medium is generated based on identifying content of the second medium. The Final Office Action fails to address this limitation. Tsuboka and Robinson fail to show or suggest such information. Appellants respectfully request that the rejection of claim 20 as being unpatentable over Tsuboka in view of Robinson be reversed.

**iv) Claims 21-23**

Claims 21-23 are rejected in Section E-35 of the Final Office Action as being unpatentable over Tsuboka and Robinson for the reasons set forth for claim 20. Claims 21-23 depend from claim 20. The Final Office Action fails to address the limitations of these claims



and, thus, fails to establish a *prima facie* case of obviousness against these claims. Tsuboka and Robinson fail to render these claims obvious for at least the reasons set forth above with respect to claim 20. For at least this reason, appellants respectfully request that the rejection of claims 21-23 based on Tsuboka and Robinson be reversed.

**v) Claims 37 And 67-69**

Claims 37 and 67-69 are rejected in Section E-35 of the Final Office Action as being unpatentable over Tsuboka and Robinson for the reasons set forth for claim 20. The Final Office Action fails to address the limitations of these claims and, thus, fails to establish a *prima facie* case of obviousness against these claims. Claim 37 is an apparatus claim that is generally analogous to method claim 2. Claims 67-69 depend from claim 37. Tsuboka and Robinson at least fail to suggest a microcomputer that stores information from a first medium and coordinates a presentation using the information with a presentation of a received second medium based on determining content of the second medium. The Examiner acknowledged with respect to claim 2 that Tsuboka does not suggest determining the content of a TV program. The Examiner relies on Robinson to show a user that determines content of the TV program. However, claim 37 sets forth a microcomputer that acts based on determining content of the second medium. The Examiner reliance on the user of Robinson does not suggest a microcomputer as set forth by claim 37. Claims 67-69 depending from claim 37 are also patentable over Tsuboka and Robinson for at least this reason. Appellants respectfully request that the rejections of claims 37 and 67-69 based on Tsuboka and Robinson be reversed for at least the above reasons.

**I. Rejection Based On Betts And “Mode II” Captioning**

Claims 2-8, 11-18, 37-41, 67-72 and 85-90 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Betts in view of the “Mode II” captioning feature of the “ANTIOPE” teletext standard as discussed in: the article “Development & Applications of the Antiope-Didon Technology” by J. Guillermin (“Guillermin”); the “CBS/CCETT North American Broadcast

Teletext Specification (Extended Antiope)” (“CBS/CCETT Spec.”); and the article “Antiope Teletext Captioning” by Claude Sechet (“Sechet”).

As an initial matter, appellants note that there is no indication in the cited art that Mode II captioning is prior art against appellants’ claims. The Examiner, at pages 93-96 of the Final Office Action, includes a summary of his understanding of Mode II captioning. This summary is not itself prior art. The summary is also misleading. The Final Office Action appears to rely on a description of Mode II caption from the CBS/CCETT Spec., which is subtitled “Extended Antiope.” There is no suggestion in the cited art that Mode II captioning is part of the ANTIOPE standard. Accordingly, the Examiner has not shown that the “Mode II” captioning feature is included in the “ANTIOPE” teletext standard. The rejection based on the “Mode II” captioning feature of the “ANTIOPE” teletext standard is therefore improper, as it does not rely on prior art.

With respect to the CBS/CCETT Spec., appellants submit that the Examiner has failed to establish that the reference qualifies as prior art to the claims of the instant application. “A reference is proven to be a ‘printed publication’ ‘upon satisfactory showing that such document has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, can locate it.’” M.P.E.P. § 2128 (8<sup>th</sup> Ed. Rev. 2 2004) (quoting *In re Wyer*, 655 F.2d 221, 226, 210 U.S.P.Q. 790, 795 (C.C.P.A 1981)) “[P]ublic accessibility [is] the criterion by which a prior art reference will be judged for the purposes of § 102(b).” *In re Klopfenstein*, 380 F.3d 1345, 1350, 72 U.S.P.Q.2d 1117, 1120 (Fed. Cir. 2004). The Examiner has not made a satisfactory showing that the CBS/CCETT Spec. is included in a document that has been made available to the extent that persons interested in the subject matter, exercising reasonable diligence, can locate it. Although the relied upon document's cover page bears a date of May 20, 1981, no showing has been made that the document was disseminated or accessible by those of ordinary skill in the art by that date. Appellants acknowledge that the CBS/CCETT Spec. was the subject of testimony given in connection with an International Trade Commission investigation involving appellants' related issued patents (*In re Certain Digital Satellite Sys. (DSS) Receivers & Components Thereof*, No.

337-TA-392). However, that testimony also fails to establish when that the document was disseminated or accessible.<sup>12</sup>

There is no showing that the public could access the CBS/CCETT Spec. at the FCC through the exercise of reasonable diligence. Appellants' representatives have attempted to locate the documents at the FCC. The document could not be located through the exercise of reasonable diligence. The librarian at the FCC provided the docket cards "In the Matter of Amendment of Part 73 to Authorize the Transmission Teletex by TV Stations." The docket cards bear the designations BC- 81-741, RM-3727 and RM-3876. The docket includes no entries on May 20, 1981 (the date on the face of the CBS/CCETT Spec.). The FCC librarian indicated that to locate the specification one would need to visit the Federal Records Center and page through the entire record of the proceeding. Accordingly, there is no indication that the cited specifications were made available to the extent that persons interested and ordinarily skilled in the teletex art, exercising reasonable diligence, could locate them. The Examiner has not satisfactorily demonstrated that the cited CBS/CCETT Spec. is a printed publication.

Appellants respectfully submit that for the above reasons, all rejections that rely on the CBS/CCETT Spec. should be reversed. Appellants note, however, that the pending claims are in any event allowable over the various combinations of references that include the CBS/CCETT Spec. for the reasons set forth below.

The rejections of claims 2-8, 11-18, 37-41, 67-72 and 85-90 purport to rely on the disclosure of Betts. The Final Office Action at pp. 96-97 asserts "that it would have been obvious to one of ordinary skill in the art to have utilized computer implemented teletext receivers/decoders, e.g. of the type described in Betts et al., for receiving and displaying conventional teletext data of the 'ANTIOPE' teletext standard including conventional 'Mode II' captioning provided therein." The Final Office Action offers no explanation regarding how to modify the Betts device to be used in the "ANTIOPE" system. To the contrary, the Final Office

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<sup>12</sup> The pertinent testimony was attached at Tab A to the October 2004 Response to the Final Office Action.

Action does not rely on the features disclosed in Betts whatsoever, rather, the Final Office Action sets forth a list of “circuitry/software” the Examiner asserts would necessarily comprise a computer for receiving and decoding teletext. There is no showing where any of these features are actually shown in the prior art. For at least these reasons, appellants submit that the rejections based on Betts in view of “Mode II” captioning are improper and respectfully request that they be reversed.

**i) Claim 2**

Section E-36 of the Final Office Action includes a rejection of claim 2 as being unpatentable over Betts in view of “Mode II” captioning. Claim 2 sets forth that a multimedia presentation is output through the coordination of a presentation, under computer control, using information from a first medium with a presentation of a second medium, whereby the presentation using information in the first medium has a predetermined relationship to the content of the second medium.

The Final Office Action fails to demonstrate that any of the limitations of claim 2 are shown or suggested by actual prior art for the reasons set forth above. However, the statement that a computer implementing “Mode II” captioning would necessarily comprise “Circuitry/software for determining ‘content’ of a second medium received in said plurality of signals” is notably erroneous. The Final Office Action asserts that “this limitation refers to nothing more than the detection of the ‘display control signal’ being that said display control signal at least represents the ‘content’ of the audio component of the TV programming to which the locally generated images/captions are to be synchronously displayed.” “Display control signals” do not identify content merely because they cause a graphic to be displayed with audio. As discussed in 5 above, the term “content” should be interpreted to mean substance, gist, significance, or meaning. In appellants’ specifications, for example, program identifiers are used to actually determine what television program is to be broadcast. Such identifiers can be used to determine the content of television programming. There is no suggestion that any “display

control signals” or “reveal codes” of the Mode II captioning protocol identify the substance, gist, significance, or meaning of the audio component of the TV programming. No content of the audio component of the TV programming is thus determined based upon a “display control signal” as suggested in the Final Office Action. For at least these reasons, appellants respectfully request that the rejection of claim 2 based on Betts and “Mode II” captioning be reversed.

**ii) Claims 3-8 And 11-18**

Claims 3-8 and 11-18 are rejected as being unpatentable over Betts in view of the “MODE II” captioning feature for the same reasons set forth for claim 2. Claims 3-8 and 11-18 depend from claim 2. These rejections are improper for the reasons set forth above with respect to claim 2. Appellants respectfully request that the rejections of claims 3-8 and 11-18 based on Betts in view of “Mode II” captioning be reversed for this and the following reasons.

The Final Office Action is particularly erroneous with respect to claims 7 and 8 for reasons similar to those set above with regard to claim 2. Claim 7 sets forth that the content of the second medium explains a significance of the presentation using the information from the first medium. Claim 8 depends from claim 7 and sets forth that the content of the second medium explains the significance in audio. The Final Office Action, in section E-37, asserts that “the recited ‘content’ merely refers to the fact that the ‘display command signal’ of appellant’s ‘Wall Street Week’ embodiment arguably identified location of ‘content’ in the audio/video components of the TV programming with which the display of the ‘locally generated’ images are to be synchronized.” This statement is incorrect. Identifying a location within a program is not necessarily determining content of a program, as a location may be identified independently from any reference to content at the location. In appellants’ “Wall Street Week” embodiments, the audio of the TV program explains that the graphic using the stock quote information is the performance of the user’s portfolio. There is no suggestion that the audio or any other component of TV programming used with “Mode II” captioning explains the significance of any of the captions.

Claims 13 and 14 further define the step of determining. Claim 13 sets forth that the step of determining comprises processing an identifier. Claim 14 sets forth that the identifier identifies the content of the second medium. As discussed above with respect to claim 2, the “display control codes” relied upon in the Final Office Action do not include identifiers that identify content of the TV program.

Claim 17 sets forth storing the second medium at the receiver station. The Examiner takes Official Notice that it was notoriously well known to include video recording devices at household receiving locations for recording broadcast TV programming for later playback. Appellants traverse this Official Notice to the extent that the Examiner is asserting that it was known to include video recording devices at any type of household receiver. The Examiner is relying on a proposed advanced teletext specification. There must be some suggestion in the prior art that this advanced teletext specification is compatible with recording devices to establish a proper rejection under 35 U.S.C. § 103.

**iii) Claims 37-41 And 67-69**

In Section E-38 of the Final Office Action, claims 37-41 and 67-69 are rejected as being unpatentable over Betts in view of “Mode II” captioning for the same reasons that were set forth for claims 3-8, 11, 12, 17 and 18. Claim 37 is an apparatus claim that is generally analogous to method claim 2. Claims 38-41 and 67-69 depend from claim 37. The rejection of these claims based on Betts and “MODE II” captioning is improper for the reasons set forth above with respect to claims 2 and claims 3-8 and 11-18. Claim 37 sets forth a microcomputer that stores information from a first medium and coordinates a presentation using the information with a presentation of a received second medium based on determining content of the second medium. The Final Office Action fails at least to demonstrate that the prior art shows or suggests such a microcomputer. Accordingly, appellants respectfully request that the rejections of claims 37-41 and 67-69 based on Betts in view of “Mode II” captioning be reversed.

**iv) Claims 70-72**

In Section E-39 of the Final Office Action, claims 70-72 are rejected as being unpatentable over Betts in view of “Mode II” captioning for the same reasons that were set forth for claim 2. This rejection based on Betts in view of “Mode II” captioning is improper for the reasons set forth above.

Claim 70 sets forth a multimedia presentation apparatus including an output device for outputting a coordinated presentation of a first medium and information from a second medium; a receiver for receiving a plurality of signals including an identifier, the first medium and the second medium; and a microcomputer for identifying content of the first medium based on the identifier and executing processor instructions to enable the coordinated presentation of the first medium and information based on the second medium.

The Final Office Action asserts that the identifier of claim 70 reads on the reveal/unmask code which identifies content of the TV programming. Similar to the rejection of claim 2, the Final Office Action merely asserts that the reveal/unmask code marks a specific location of the TV programming. However, the location of the reveal/unmask code does not identify content of the TV program (i.e., it does not identify the substance, gist, meaning, or significance of the program). In appellants’ disclosures, a program identifier is used to identify the content of the TV program. The Final Office Action fails to demonstrate that the prior art suggests a microcomputer for identifying content of the first medium based on the identifier as set forth in claim 70.

Claim 71 and 72 depend from claim 70. The rejection of these dependant claims is improper for at least the reasons set forth above with respect to claim 70. Appellants respectfully request that the rejections of claims 70-72 based on Betts in view of Mode II captioning be reversed for at least the above reasons.

**v) Claims 85-90**

In Section E-40 of the Final Office Action, claims 85-90 are rejected as being unpatentable over Betts in view of “MODE II” captioning for the same reasons that were set

forth for claims 70-72. The rejection based on Betts in view of "MODE II" captioning is improper for the reasons set forth above. Claim 85 sets forth a multimedia presentation apparatus including a microcomputer for creating a series of discrete video images based on processing a control signal, identifying content of a first medium, and causing a video image of the discrete video images to be output. The apparatus also includes an output device at which the video image is combined into a multimedia presentation including the first medium.

The Final Office Action fails to address the elements of claims 85-90 and thus fails to establish a *prima facie* case of obviousness against claims 85-90. The prior art fails to show or suggest at least a microcomputer for creating a series of discrete video images and identifying content of a first medium as set forth by claim 85. Claims 86-90 depend from claim 85. Appellants respectfully request that the rejections of claims 85-90 based on Betts in view of Mode II Captioning be reversed.

#### **J. Rejection Based On Hedger, Gunn And Yoshino**

Claims 2, 3, 5-8 and 11-15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the three reference combination of the publication entitled "Telesoftware: Home Computing Via Broadcast Teletext" by J. Hedger ("Hedger") in view of the publication entitled "A Public Broadcaster's View of Teletext in the United States" by Hartford Gunn and Gregory W. Harper ("Gunn") and Yoshino.

Hedger is directed using the ORACLE teletext service as a source of broadcast software. Gunn is directed to possible uses for teletext systems in the United States. Yoshino, as discussed above, is directed to an electronic calculator that outputs a multiple row display in superposition with television.

##### **i) Claim 2**

In Section E-41 of the Final Office Action, claim 2 is rejected as being unpatentable over Hedger in view of Gunn and Yoshino. In claim 2, a multimedia presentation is output through the coordination of a presentation, under computer control, using information from a first



medium with a presentation of a second medium, whereby the presentation using information in the first medium has a predetermined relationship to the content of the second medium.

Specifically, claim 2 sets forth determining content of the second medium. Claim 2 also sets forth coordinating, at the receiver station under computer control, a presentation using the information with a presentation of the second medium based on the step of determining.

None of the cited references show or suggest a step of coordinating as set forth in claim 2. Hedger includes no suggestion to coordinate a presentation using broadcast software with a TV program. Gunn includes no suggestion to coordinate a presentation output by software with a TV program. The Final Office Action asserts, "When executing telesoftware pertaining to 'program related' applications, it would have been obvious, in fact necessary, to have enabled the display device in Hedger's figure 1 to simultaneously display the computer generated video and the received 'Wall Street Week' TV programming." There is, however, no suggestion found in the cited references to have used the device of Hedger to display such program related applications. Gunn, relied upon to show "program-related" applications, also fails to teach a coordinated display. Gunn specifically states that the operation of "program-related" teletext assumes that the teletext decoder will be connected to the home computer and does not suggest the coordinated display of television and computer output. There is no suggestion in either Hedger or Gunn to coordinate, at a receiver under computer control, a presentation based on two media.

The Final Office Action further relies on Yoshino to show a coordinated display. There is no motivation found in the applied art to combine Hedger, Gunn and Yoshino. There is no suggestion in Yoshino of program-related software. There is no suggestion in Hedger or Gunn to coordinate software output with a TV program. Appellants' specification provides the only guide to combine these three references in the manner suggested in the Final Office Action to result in "program-related" application output coordinated with TV programming. Absent appellants' specification, there is no motivation found in the cited art to combine the references in the manner suggested by the Final Office Action.

Furthermore, the Final Office Action asserts that the step of determining content is met by the user of the modified Hedger system receiving verbal instructions. However, the step of coordinating is at the receiver station under computer control and is also based on the step of determining. It is unclear how a step of coordinating can be based on the user reception of verbal instructions. For example, the applied art fails to address how the system would handle or adjust to the myriad of different ways users may react to the instructions. More important, the applied art fails to suggest how the system would adjust to various reaction times of users or to non-compliance by users. These and many other problems are not addressed in the applied art as required to suggest a step of coordinating based on a step of determining performed by a user. It would not be obvious to one of ordinary skill in the art to combine the cited references in the manner suggested by the Final Office Action, as the cited art addresses none of these issues. For the above reasons, appellants respectfully request that the rejection of claim 2 based on Hedger in view of Gunn and Yoshino be reversed.

**ii) Claims 3, 5-8 And 11-18**

In Section E-42 of the Final Office Action, claims 3, 5-8 and 11-18 are rejected as being unpatentable over Hedger in view of Gunn and Yoshino. Claims 3, 5-8 and 11-18 depend from claim 2 and thus include each limitation of claim 2. The Final Office Action includes no attempt to address the limitations of claims 3, 5, 7, 8, and 13-16 and, thus, fails to set forth a *prima facie* case of obviousness against these claims. Hedger, Gunn and Yoshino fail to show or suggest each limitation of claims 3, 5-8 and 11-18 for at least the reasons set forth above with respect to claim 2.

Claim 17 sets forth storing the second medium at the receiver station. The Examiner takes Official Notice that it was notoriously well known in the TV art to have included video recording devices at household receiving locations for recording broadcasted TV programming for later playback. However, there is no explanation how such a recording device would interact with “program-related” applications. Appellants traverse the Official Notice to the extent that

the Examiner is asserting that it was known to record programming included in a coordinated presentation. Appellants respectfully request that the rejections of claims 3, 5-8 and 11-18 be reversed.

#### **K. Rejection Based On Hutt In View Of Betts**

Claims 2, 3-6, 5-8 and 11-15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent 3,961,137 to Peter Richard Hutt et al. (“Hutt”) in view of Betts. Hutt is directed to a television system in which data is transmitted in the blanking intervals of the video signal.

Claim 2 sets forth that a multimedia presentation is output through the coordination of a presentation, under computer control, using information from a first medium with a presentation of a second medium, whereby the presentation using information in the first medium has a predetermined relationship to the content of the second medium. Claim 2 sets forth a step of determining content of the second medium. The Final Office Action asserts that Hutt includes “[c]ircuitry for detecting [i.e., thereby ‘determining’] the sync signal ‘content’ of the video-type media.” As discussed in Section 5 above, detecting sync signals is not determining content of a medium. Detecting sync signals does not determine the substance, gist, meaning, or significance of the video medium. Hutt fails to show a step of determining content of a second medium as set forth by claim 2.

Claim 2 further sets forth coordinating, at a receiver station under computer control, a presentation using the information from the first medium with a presentation of the second medium based on the step of determining. The presentation using the information has a predetermined relationship to the content of the second medium. There is no suggestion in Hutt that the presentation of the text is coordinated with the display of the TV programming such that the text has a predetermined relationship to the content of the TV programming.

The secondary reference to Betts corrects none of these deficiencies of Hutt. The Final Office Action acknowledges that the receiver station of Hutt is not under computer control.

Betts is relied upon to show computer control of a receiver station. There is no suggestion in Betts of a computer that controls a receiver station to determine content of any medium or to coordinate a presentation such that information from a first medium has predetermined relationship to content of a second medium. There is no motivation found in the applied art to modify Hutt to include any such computer. For at least the above reasons, appellants respectfully request that the rejection of claim 2 based on Hutt in view of Betts be reversed.

**i) Claims 3-6, 11-14 And 18**

In Section E-44 of the Final Office Action, claims 3-6, 11-14 and 18 are rejected as being unpatentable over Hutt in view of Betts for the same reason that was set forth for claim 2. Claims 3-6, 11-14 and 18 depend from claim 2 and, thus, include each limitation of claim 2. Hutt in view of Betts fails to show or suggest each limitation of these claims for at least the reasons set forth above with respect to claim 2. The Final Office Action is silent regarding the limitations set forth in claims 3-5, 11 and 12, and, thus, fails to establish a *prima facie* case of obviousness against these claims.

Claims 13 and 14 define further aspects of the step of determining absent from the applied art. Claim 13 sets forth that the step of determining comprises processing an identifier. Claim 14 depends from claim 13 and sets forth that the identifier identifies the content of the second medium. In the Final Office Action, it is asserted that the sync signal components of a video signal are “identifiers” which identify the specific sync/timing content of the video signal. This assertion is erroneous and highlights the flaws in the Examiner reasoning. The timing of the video signal is independent the content of the television program. The sync signals are not identifiers that identify the content of the television program, as they are the same for every television transmission. Appellants respectfully request that the rejections of claims 3-6, 11-14 and 18 be reversed.

## **L. Rejection Based On Fujino**

In Sections E45-46, the Examiner rejects claims 2, 3, 4, 7, 10, 13-15, and 17 under § 103(a) as being unpatentable over U.S. Patent No. 4,675,737 to Fujino et al. (“Fujino”). Appellants respectfully submit that: (1) Fujino is not an available reference due to appellants’ asserted priority date for the reasons set forth in Section 2 above, and (2) claims 2, 3, 4, 7, 10, 13-15, and 17 are patentable over Fujino.

Appellants respectfully submit that this rejection must be reversed for the reason that Fujino is not available as prior art. Furthermore, Fujino fails to render claims 2, 3, 4, 7, 10, 13-15 and 17 unpatentable under § 103(a). Fujino describes an apparatus used to superimpose the text from a character signal over video from a video signal. Fujino discloses an apparatus for reproducing (i.e., playing) a video disc and a superimposing apparatus which generates a character signal from a ROM cartridge supplied to the superimposing apparatus. The superimposing apparatus generates a character signal (representing, e.g., close captioning text in a particular language) corresponding to positional information included in the video signal. Thus, the superimposing apparatus of Fujino utilizes a standard video disc manufactured for use in various geographic locations with an appropriate ROM cartridge containing foreign language character data corresponding to the video dialogue. The Examiner asserts that Fujino only fails to disclose the “computer” recited in claims 2, 3, 4, 7, 10, 13-15 and 17, and the Examiner indicates that he takes Official Notice that it was well known that software driven computers could be used in place of dedicated hardware when implementing signal processing circuitry.

Fujino, however, fails to teach or suggest “receiving said plurality of signals, at least a portion of said plurality of signals being received from a source external to said receiver station, said plurality of signals including at least two media” as required by claim 2. The Examiner asserts that Fujino discloses a “video reproducing apparatus (e.g., 1 of Figure 1) which receives a first signal representing an encoded video signal “media,” wherein the first signal is received from an external source via a first recording medium (e.g., via a video disc).” (Final Office Action p. 107.) The Examiner relies on the video signal from the video disc as the source of the

“first signal.” The video disc/signal, however, is integral to the receiver station and is not received from an external source.

Fujino also fails to teach or suggest “determining content of a second medium received in said plurality of signals” and the recited “coordinating” based on the step of determining. The Examiner asserts that the “sync separator 12 of figure 2 which detects (and thereby ‘determines’) a data signal content of the video signal ‘media’” or the “[d]ata detection circuitry (e.g. 13, 20, 22, of figure 2) which detects (and thereby ‘determines’) a data signal content of the video signal ‘media’ ” discloses determining the content of a second medium. As discussed in Section 5 above, the mere detection of video sync signals fails to suggest determining content of the television program. The data detection circuitry of Fujino does not suggest determining content of a second medium. First, mere detection of a data signal does not necessarily determine the content of the data. The combination of elements of Fujino relied upon to show data detection circuitry -- comparator 13, shift register 20, and comparator 22 -- are used to extract positional data from the video signal. Fujino col. 4, l. 41 - col. 5, l. 2. This positional data does not represent the substance, gist, meaning, or significance of any video or character data. Accordingly, the detection of this positional data is not determining content of the video signal as asserted in the Final Office Action. Appellants respectfully request that the rejections of claims 2, 3, 4, 7, 10, 13-15 and 17 based on Fujino be reversed.

#### **M. Rejection Based On “Mode II” Captioning And Teletext**

Claims 2-8, 11-18, 20-23, 37-41, 67-72 and 85-90 stand “rejected under 35 U.S.C. 103(a) as being unpatentable over the notoriously well known ‘Mode II’ captioning feature of a conventional ANTIOPE teletext data service (as discussed in paragraph D-2 of this Office action) in view of the notoriously well known computer driven Teletext decoder structure (as discussed in paragraph C-4 of this Office action).” This rejection is improper. The rejection makes no attempt whatsoever to set forth “the relevant teachings of the prior art relied upon,

preferably with reference to the relevant column or page number(s) and line number(s) where appropriate.” M.P.E.P. § 706.02(j). The rejection makes no reference to any prior art, but rather relies on sections of the Final Office Action written by the Examiner specifically to provide a basis for rejecting appellants’ claims. “Where a reference is relied upon to support a rejection, whether or not in a minor capacity, that reference should be positively included in the statement of the rejection.” *Id.* (citing *In re Hoch*, 428 F.2d 1341, 1342 n. 3, 166 U.S.P.Q. 406, 407 n. 3 (C.C.P.A. 1970)). As these rejections are based on no specifically identifiable prior art references, they should be reversed.

The Examiner mischaracterizes “Mode II” captioning as a feature of ANTIOPE teletext. The Final Office Action cites no references that show that any operating ANTIOPE system included “Mode II” captioning. Accordingly, the Examiner has not demonstrated that “Mode II” captioning itself is prior art.

In both paragraphs C-4 and D-2, which serve as the basis of this rejection, the Examiner alleges that features found in a collection of references make up “well known” systems. The Examiner now attempts to apply the combination of features that he has assembled and labeled “well known” against appellants’ claims. If the combination of these features are truly notoriously well known, it should not be difficult for the Examiner to set forth in the rejection where in the prior art the features are found and to set forth a proper motivation for combining whatever references are relied upon. Without such a showing, the Examiner has failed to establish a *prima facie* case of obviousness.

Furthermore, the Examiner’s description of “Mode II” captioning fails to render appellants claims obvious for the following reasons.

With respect to claim 2, the Final Office Action at least fails to set forth any suggestion of a step of determining content of a second medium. The Final Office Action asserts that a teletext decoder for receiving “Mode II” captioning must necessarily “[d]ecode subsequent ones of the extracted packets to detect the described ‘reveal’ command which corresponds to the class of the user selected captioning (corresponding to the recited step of “determining content”).”

There is no explanation how a reveal code that indicates the class of captioning is used to determine content of a second medium (such as the television program).

With respect to claim 14, the Final Office Action fails to suggest that the step of determining comprises processing an identifier that identifies the content of the second medium. The Final Office Action asserts that “reveal” codes identify a time in the TV programming at which the program related captions are to be displayed. The Final Office Action fails to allege that the reveal codes identify content of the television program. As asserted by the Final Office Action, the reveal codes merely indicate when captioning should be displayed; there is no assertion that the reveal codes indicate what information content is included in the TV program at the time.

The Final Office Action asserts in section E-49 that claims 20-23, 37-41, 67-72 and 85-90 are rejected for the same reasons that were set forth for claims 3-8 and 11-18. The particular limitations of these claims are not addressed in the Final Office Action. These rejections should be reversed as none of the requirements of a proper rejection under 35 U.S.C. § 103 have been presented in the Final Office Action. Appellants therefore respectfully request that the rejections of claims 2-8, 11-18, 20-23, 37-41, 67-72 and 85-90 discussed above be reversed.

**N. Rejection Based On Marti And The CBS/CCETT Spec.**

Claims 2, 3-8, 11-18, 20-23, 37-41, 67-72, 85-90 stand rejected “under 35 U.S.C. § 103(a) as being unpatentable over the publication ‘The Concept of a Universal “Teletext” (broadcast and interactive Videotex) Decoder Microcomputer based’ by Marti in view the notoriously well known Mode II Captioning feature of the ANTIOPE teletext standard as described in the 1981 ‘CBS/CCETT NORTH AMERICAN BROADCAST TELETEXT SPECIFICATION (EXTENDED ANTIOPE)’ publication.” (Final Office Action, p. 113.) The Examiner takes Official Notice that the “Mode II” captioning feature of the ANTIOPE videotext specification was notoriously well known in the art at the time of appellants’ invention. The Examiner cites to the CBS/CCETT Spec. as evidence. Appellants traverse this Official Notice.



The CBS/CCETT Spec. speaks for itself. There is no evidence that the specifics of the CBS/CCETT Spec. were “notoriously well known” prior to appellants’ invention. In fact as discussed in Section I above, the Examiner has failed to establish that the CBS/CCETT Spec. qualifies as prior art to the claims of the instant application.

Marti is directed to the development of a decoder that may receive multiple forms of data from various services. Marti in view of the CBS/CCETT Spec. fails to show or suggest each element of any of appellants’ claims.

**i) Claim 2**

In Section E-50 of the Final Office Action, a rejection of claim 2 based on Marti and the CBS/CCETT Spec. is presented. The rejection merely asserts an interpretation of the relevant teachings of the cited art. The rejection fails to address the steps of claim 2. The rejection fails to set forth the differences in the claims over the cited references, proposed modification to the cited references, or any explanation of a motivation to combine the teachings of the cited references. For this reason the rejection of claim 2 is improper and should be reversed.

In claim 2, a multimedia presentation is output through the coordination of a presentation, under computer control, using information from a first medium with a presentation of a second medium, whereby the presentation using information in the first medium has a predetermined relationship to the content of the second medium. There is no showing in the Final Office Action how the cited references show or suggest any of these steps of claim 2. Significantly, claim 2 also sets forth a step of determining content of a second medium. The cited art fails to show or suggest such a step of determining. Appellants respectfully request that this rejection of claim 2 be reversed.

**ii) Claims 3-8 And 11-18**

In Section E-51 of the Final Office Action, claims 3-8 and 11-18 are rejected based on Marti and the CBS/CCETT Spec. for the same reason that was set forth for claim 2. Claims 3-8 and 11-18 depend from claim 2. These claims are patentable over Marti and the CBS/CCETT

Spec. for at least the reasons set forth above with respect to claim 2. The rejections set forth in Section E-51 of the Final Office Action are identical to the rejections set forth in section E-48 of the Final Office Action which is also based on "Mode II" captioning. These rejections are improper as set forth in Section M above. Appellants respectfully request that these rejections of claims 3-8 and 11-18 be reversed.

**O. Claims 20-23, 37-41, 67-72 And 85-90**

In Section E-52 of the Final Office Action, claims 20-23, 37-41, 67-72 and 85-90 are rejected based on Marti and the CBS/CCETT Spec. for the same reason that was set forth for claims 3-8 and 11-18. The Final Office Action fails to address the limitations of these claims and thus fails to establish a *prima facie* case of obviousness against these claims. Appellants respectfully request that these rejections of claims 20-23, 37-41, 67-72 and 85-90 be reversed.

Claim 20 sets forth that a multimedia presentation is output through the coordination of a presentation of a first medium and information based on a second medium through the identification of the content of the first and second media. The cited prior art does not suggest at least the step of identifying content of a first medium based on an identifier as set forth in claim 20. Claim 70 is an apparatus claim that is generally analogous to claim 20. The cited prior art does not suggest at least a microcomputer for identifying content of a first medium based on an identifier as set forth in claim 70. Claims 21-23 depend from claim 20 and are patentable over Marti and the CBS/CCETT Spec. for at least the above reasons. Claims 71 and 72 depend from claim 70 and likewise are patentable over Marti and the CBS/CCETT Spec. for at least the above reasons.

Claim 37 is an apparatus claim that is generally analogous to method claim 2. The cited prior art fails to show or suggest each element of claim 37 for the reasons set forth above with respect to claim 2. Marti and the CBS/CCETT Spec. fail to set forth at least a microcomputer that coordinates a presentation using information from a first medium with a presentation of a received second medium based on determining content of the second medium as set forth by

claim 37. Claims 38-41 and 67-69 depend from claim 37. These claims are patentable over Marti and the CBS/CCETT Spec. for at least the above reasons.

Claim 85 sets forth a multimedia presentation apparatus. The apparatus includes a microcomputer for creating a series of discrete video images by executing processor instructions based on processing a control signal, identifying content of a first medium, and then causing a video image of said series of discrete video images to be output. Marti and the CBS/CCETT Spec. do not show or suggest such a microcomputer. The Final Office Action asserts, “In MODE II captioning, each the ‘reveal’ codes represent [sic] a ‘control signal’ which identifies content of the first TV signal medium (e.g. a timing content, an audio content, etc, . . . ).” This statement is unclear. The CBS/CCETT Spec. does not suggest that the reveal codes identify audio content of the TV program. The timing of the reveal code does not identify any content of the TV program. Claims 86-90 depend from claim 85. These dependant claims are patentable over Marti and the CBS/CCETT Spec. for at least the reasons set forth above.

## **8. Response To Double Patenting Rejection**

In Section E53-54, the Examiner rejects claims 2-18, 20-30, 33-42, and 67-104 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 4,694,490 (the “‘490 patent”). The ‘490 patent and the instant application share common inventors.

In determining whether obviousness-type double patenting exists the relevant inquiry is whether the claim or claims pending in the current application define an invention that is merely an obvious variation of an invention claimed the issued patent. M.P.E.P. § 804. A rejection based on obviousness-type double patenting must demonstrate that the claimed subject matter is not patentably distinct from the subject matter claimed in the issued patent. *See In re Longi*, 759 F.2d 887, 225 U.S.P.Q. 645 (Fed. Cir. 1985). The M.P.E.P. instructs examiners to employ the *Graham* factors, *see Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966), used to

establish a case of obviousness when making an obviousness-type double patenting analysis.

M.P.E.P. § 804. Further, the M.P.E.P. instructs examiners that:

Any obviousness-type double patenting rejection should make clear:

(A) The differences between the inventions defined by the conflicting claims - a claim in the patent compared to a claim in the application; and

(B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in the patent.

M.P.E.P. § 804; *see also In re Kaplan*, 789 F.2d 1574, 229 U.S.P.Q. 1574 (Fed. Cir. 1986) (to support an obviousness-type double patenting rejection “there must be some clear evidence to establish why the variation would have been obvious”).

The Examiner’s obviousness-type double patenting rejection fails to discuss any *Graham* factors and fails to identify any differences between the pending claims and the claims in the ‘490 patent and the reasons why a person of ordinary skill in the art would conclude that the inventions defined in the pending claims are merely obvious variations of the inventions claimed in the claims of the ‘490 patent. Accordingly, the Examiner has not made out a *prima facie* case of obviousness-type double patenting.

The Examiner’s double patenting rejection essentially consists of an assertion that the instant claims and claims 1-13 of the ‘490 patent define obvious variants of the same invention because they rely on the same written description support in appellants’ 1981 specification (i.e., the Wall Street Week example). Without any analysis whatsoever, the Examiner lists the written description support from the 1981 specification identified by appellants and asserts that when such support is identified:

it is becomes [sic] apparent that the instant claims have simply adopted different language to recite/describe the same receiver side “Wall Street Week” overlay method/processing that has already been covered/recited via claims 1-13 of [the ‘490 patent] . . . .

Final Office Action, p. 118. Notwithstanding the fact that the Examiner's assertions fail to make out a *prima facie* case of obviousness-type double patenting, the Examiner's position is untenable because he improperly reads functions not actually recited into claims 1-13 of the '490 patent.

The Examiner merely asserts that the "Wall Street Week" disclosure in the 1981 specification supports claims 2-18<sup>13</sup> and is "covered/recited via claims 1-13" of the '490 patent. The Examiner's exclusive reliance on the disclosure of the patent instead of the scope and content of the patent claims is improper.

The M.P.E.P. cautions examiners from doing precisely what the Examiner has done in Section E-53 of the Final Office Action. The M.P.E.P. instructs examiners that in determining whether a pending claim defines an invention that is an obvious variation of an invention claimed in an issued patent, the specification of the issued patent cannot be used as prior art. M.P.E.P. § 804. The obviousness analysis is limited solely to *inventions defined by the claims*. Of course, in determining whether the claimed invention is an obvious variant of that defined by the issued claim, relevant portions of the specification can be used to ascertain the scope and meaning of an issued claim. *See In re Vogel*, 422 F.2d 438, 164 U.S.P.Q. 619 (C.C.P.A. 1970). It is, however, improper to read limitations from the specification into the claims of the issued patent. *See e.g., Donner, Irah H., Patent Prosecution: Practice & Procedure Before the U.S. Patent Office*, Ch.10.VIII.B.1 (2nd ed. 1999) (discussing *In re Vogel* and noting "[t]hus whereas the patent disclosure may be used to interpret claims, the Examiner may not read the specification into the claims in an effort to buttress a double-patenting rejection").

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<sup>13</sup> Appellants acknowledge that the description regarding "Wall Street Week" in the 1981 specification provides support meeting the requirements of 35 U.S.C. § 112, first paragraph. To the extent that the Examiner's summary of this support in Section E-53 of the Final Office Action is meant to correspond to the support set forth in the January 2003 Response, particularly the Ligler Declaration attached as Exhibit II, the summary is not entirely accurate. For example, the Examiner states, "The section 112 support for the recited 'determination' of 'content' of the 'second medium' of the instant claims is nothing more than the detection of the 'graphics-on' instruction signal." However, Dr. Ligler states, "[A] program identifier received in advance of the exemplary Wall Street Week broadcast is used to determine content of the Wall Street Week television program."

There is simply nothing to bar the allowance of later claims supported by a disclosed embodiment that is "covered" by previously issued claims provided that the later claims define an invention that is not merely an obvious variation of an the invention claimed in the issued patent. The pending claims of the instant application contain numerous steps and other limitations which are not found or suggested in claims 1-13 of the '490 patent. For example, at a minimum, none of claims 1-13 of the '490 patent include steps directed to determining or identifying content of a first or second medium. Claims 1-13 of the '490 patent do not explicitly or implicitly include the steps of determining content of a second medium or storing information from a first of at least two media (included in independent claim 2) or a microprocessor that stores information from a first of at least two media and coordinates a presentation based on determining content of a second medium (included in independent claim 37). Claims 1-13 of the '490 patent do not explicitly or implicitly include the steps of receiving a first of a plurality of signals including an identifier or identifying content of the first medium based on the identifier (included in independent claim 20) or a microcomputer for identifying content of a first medium based on an identifier (included in independent claim 70). Claims 1-13 of the '490 patent do not explicitly or implicitly include a step of comparing first information stored at the receiver station to second information corresponding to content of a television program to determine whether to present a second medium based on third information received from a source different from that of the first medium (included in independent claim 24) or a microcomputer that performs such a step (included in independent claim 74). Claims 1-13 of the '490 patent do not explicitly or implicitly include steps of receiving, at the receiver station, two media from different sources or identifying content of a first and content of a second media (included in independent claim 26) or multiple receivers for receiving multiple media and a microcomputer for identifying the content of multiple media (included in independent claim 76). Claims 1-13 of the '490 patent do not explicitly or implicitly include a step of identifying content of a first medium (included in independent claim 29) or a microcomputer for identifying content of a first medium (included in independent claim 85). Claims 1-13 of the '490 patent do not explicitly or implicitly include

steps of receiving a user response or comparing the user response to information corresponding to content of a first medium (included in independent claim 33) or microcomputer for receiving a user response and comparing the user response to information corresponding to content of a first signal (included in independent claim 95). Accordingly, appellants respectfully request that the obviousness-type double patenting rejection of the pending claims be reversed.

In Section E-54 of the Final Office Action, claims 20-30, 33-42 and 67-104 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of the '490 patent for the same reasons that were set forth for claims 2-18. The Examiner fails to address the limitations of these claims and thus fails to set forth a *prima facie* case of obviousness-type double patenting against these claims. Furthermore, the Examiner's improper rejection of claims 2-18 is based on Dr. Ligler's use of disclosure regarding "Wall Street Week" to demonstrate support for claims 2-18. Appellants note that Dr. Ligler cites to disclosure regarding a cooking show to demonstrate support for claims 24, 25, 33-36, 74, 75 and 95-104. Accordingly, the double patenting rejection as presented against claims 2-18 is not applicable to claims 24, 25, 33-36, 74, 75 and 95-104, and should therefore be reversed.

## **9. Ancillary Issues**

At various points in the Final Office Action, the Examiner refers to documents that are not specifically relied upon in rejecting or objecting to any particular claim (see, e.g., Sections C, D, E-20 and Appendix VII of the Office action). Appellants do not address the Examiner's various representations and assertions regarding those documents. Of course, appellants will fully address any such documents in the instant application or in any of appellants' copending applications, including the issue of whether or not such documents qualify as prior art, if they are ever relied upon in a formal rejection or objection to any pending claim.

### **A. Response To Appendix VI**

In Appendix VI of the Final Office Action, the Examiner repeats a list of more than 30 "Examples"/"Issues" all of which, except number 33, were included in prior Office actions. The

“Examples”/“Issues” discuss miscellaneous issues arguably related to 35 U.S.C. §§ 112 and 120. This is the third time in which the vast majority of these “Examples”/“Issues” have appeared in an Office action in this application. In the July 2002 Office Action, the Examiner stated that the list of “Examples” would be maintained by the Patent Office in all of applicants’ related applications “in an attempt to ensure consistency in the way that these issues are handled between applications in the future.” (July 2002 Office Action, p. 56.) Appellants do not object to the Examiner maintaining a list of disputed issues raised during the prosecution of this application and appellants’ related applications. Appellants do object to the inclusion of items from the list in Office Actions in which they are not relevant. Notwithstanding the Examiner’s attempt to ensure consistency, the list of Examples is an ever-changing “list” with numerous additions, deletions, and other changes appearing over time.<sup>14</sup> While the Examiner has taken time to correct minor grammatical errors and make substantive revisions to many of these “Examples”/“Issues,” the Examiner has not commented on, or even acknowledged, appellants’ prior responses to the “Examples”/“Issues.”

Appellants have previously responded to all of the 33 “Examples”/“Issues,”<sup>15</sup> and continue to believe that all of these “Examples”/“Issues” should be withdrawn in their entirety. Appellants reserve their right to further address any issue raised in the “Examples”/“Issues” if the Examiner makes an actual rejection or objection based on any of the issues raised in the “Examples”/“Issues.”

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<sup>14</sup> For example, prior to the Office actions received in 2004 in the instant application and application serial number 08/470,571, the most recent “List of Examples” appeared in the Office action mailed on July 30, 2003 in application serial number 08/444,788. While many of the changes between the list appearing in the Office action mailed on July 30, 2003 and the Final Office Action are trivial and grammatical corrections, the Examiner has deleted several “Examples” (e.g., “Examples 22, 24, and 26 have been removed) and inserted substantive additions to others.

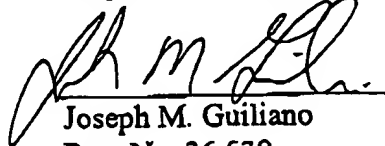
<sup>15</sup> See, e.g., appellants’ January 2003 Response filed in the instant application and applicants’ January 30, 2004 Response filed in application serial number 08/444,788.



**10. Conclusion**

In accordance with the foregoing, it is respectfully submitted that the Examiner has failed to establish that the claims of the instant application are unpatentable under 35 U.S.C. §§ 102, 103(a), 112 or under the doctrine of obviousness-type double patenting. All pending claims are patentably distinguishable over the prior art of record, taken in any proper combination. Accordingly, appellants respectfully request that the Examiner's rejections be reversed and the application be returned to the Examiner for allowance.

Respectfully submitted,



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